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IN THE

Supreme Court of the United States

..... TERM, ...

No. 646

JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW,

Petitioners,

vs.

CABOT SHOPS, INC., and HOWARD SUPPLY COMPANY,

Respondents.

Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

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JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW,

Petitioners,

vs.

CABOT SHOPS, INC., and HOWARD SUPPLY COMPANY,

Respondents.

Petition for a Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit.

Petitioner prays that a Writ of Certiorari be issued to review the judgment of the United States Court of Appeals for the Ninth Circuit entered in the above case on September 21, 1959.

Citation of Opinions Below.

The judgment and findings of fact and conclusions of law of the District Court and admissions in Pretrial Order and in papers filed during Pretrial adopted as findings of fact, are printed in Appendix B hereto *infra*, pages 15-27, inclusive. It is unreported. The opinion of the Court of Appeals, R. pp. 993-1002, is printed in Appendix B *infra*, pages 3-14, and is reported at 270 F. 2d 539, 123 U. S. P. Q. 60.

Jurisdiction.

The judgment of the Circuit Court of Appeals was entered on the 21st day of September, 1959 [R. p. 1003], Appendix B page 14 *infra*. Rehearing was denied on the 28th day of October, 1959, R. p. 1004. The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254, Sub. 1.

Question Presented.

1. Where all claims of a patent have been held valid, in determining whether claim 5 of the patent, which was allowed without amendment, is infringed, may such claim be limited to the particular form of the invention illustrated by the drawings by implying a limitation not present in claim 5 and present in claim 1, which claim 1 was introduced during prosecution of the application after rejection of broader claims?

2. Is the conclusion of law #4 by the District Court, that the range of equivalents to which the patent is entitled, in view of the prior art, does not include the accused device, a finding of fact of non-equivalency which may not be disturbed unless clearly erroneous, in the absence of subsidiary finding of fact to support the conclusion?

3. Is the conclusion of law #4 overborne by subsidiary findings of fact included by reference in finding of fact #2, made by the District Court as to the similarities of construction and operation of the patented accused device?

4. Are the valid claims, introduced after rejection of broader claims, limited by file wrapper estoppel to the particular form stated in claim 1, so as to be denied all benefits of the doctrine of equivalents?

While not urged as a ground for grant of the writ, since, if our contentions with regard to claim 5 are valid, they would also determine infringement, we intend, should this petition be granted, to urge that claims 2 and 3 are not limited to the form of the invention defined by claim 1 and clearly include the accused form.

Statutes Involved.

The statutes involved are U. S. Constitution, Article I, Sec. 8, clause 8; C. 950, 66 Stat. 792, Title 35, Sec. 112, 271(a), 281, 283. They are printed in Appendix A, *infra*, pages 1 and 2.

Statement.

The original action was brought in the District Court for infringement of Patent No. 2,671,537, because of the manufacture and sale by defendant of drive-in, portable oil well derricks sold by the defendant under the trade name Clipper. The Court of Appeals characterized the invention of the patent [R. p. 994, App. B p. 4], as follows:

> "The patent in suit involves a portable derrick of the type used for drilling and servicing oil wells. A telescopic derrick is mounted above the driver's cab at the front end of a truck chassis. An engine is mounted at the rear of the chassis. Winches are positioned between the driver and the engine. A hinge about which the derrick rotates is so positioned at the front of the chassis that when the derrick is transported it lies above the engine and the driver with its bottom to the front of the chassis. Means are provided to rotate the derrick on the hinge so

that it may be erected. The derrick is transported in a collapsed position but is extended to working height on erection."

It characterized the deficiencies of the prior art as follows [R. pp. 994-995, App. B *infra*, p. 5]:

"First among these was the necessity of having to back the truck into position at the well head. The backing process was often time-consuming and difficult to accomplish. Second, this back-in type of derrick presented certain problems with regard to safety. It had only a small margin of stability. Moon testified that he had seen a back-in unit over-turn. In addition, the hinging of the derrick at the rear of the chassis created some danger to the driver in the event the derrick should fall back during or after the erection process. Third, the back-in type, because of its weight and arrangement of components, was illegal for transportation over the highways of many states."

The structure illustrated by drawings in the patent [Pltf. Ex. 1, R. pp. 109, 638] is shown on Figs. 1, 3, 4, 6, 10 and 11. These figures are reproduced in Appendix B pages 40-43. The defendants' structure [see Find. 10, R. p. 89; App. B p. 16] is shown in pages 1883, 1884 and 1885 of Plaintiff's Exhibit 54 and page 1810 of Exhibit 55 [R. p. 345], and Plaintiff's Exhibits 93 and 94 [R. p. 359]. These exhibits are physical exhibits, and Exhibits 93 and 94 are reproduced on a reduced scale in Appendix B pp. 44-45].

In the defendants' structure the cab is moved backwards so that the hinge is above, *i.e.* at a higher elevation than, the driver's position and just ahead of the cab,

while in the form illustrated in the figures in the patent, the hinge is above the driver's position and immediately over the cab. [Compare Figs. 1, 3, 4, 6, 10 and 11 of Pltf. Ex. 1 and Pltf. Exs. 93 and 94; see opinion of Appellate Court, R. p. 999, App. B p. 11].

The District Court found that the invention described in the patent represents an inventive advance over the prior art [Find. 9, App. B p. 16]. It found, however, that the claims are not infringed and entered its conclusion of law No. 4 [R. pp. 88-91, App. B p. 17]. The District Court also adopted by reference as findings of fact [Find. 2, R. p. 89, App. B p. 15] certain facts alleged in Plaintiffs' Pretrial Statement of Facts [R. pp. 28-49] and others stipulated to be true in the pretrial order [R. pp. 57, etc.]. These stipulated facts so incorporated as Findings of Fact are printed in Appendix B pp. 18-27. The District Court held the patent valid in all of its claims [See Judgment. R. p. 90, App. B p. 17] and not infringed.

The Appellate Court affirmed the judgment [R. p. 1003, and Opinion, App. B p. 14]. It agreed with the District Court's finding that the structure described in the patent represented an inventive advance over the prior art [R. pp. 997-998, App. B pp. 8-9].

It agreed with the District Court that the patent is a narrow one and should be restricted to a narrow range of equivalents. The Appellate Court analyzed the claims in the patent to construe their meaning in the light of the specification and the file wrapper history and concluded that all of the claims were to be read as limited to the same specification as Claim 1 [R. pp. 1001-1002, App. B p. 14].

The claims are printed in tabular form [App. B p. 31 to 39 as they were introduced in evidence [Pltf. Ex. 1-A, R. p. 110, pp. 647-656]. The Appellate Court's opinion [R. pp. 1000 to 1001, App. B pp. 12 and 13] does not give all of the significant portions of the claims necessary for the understanding of the scope of the claims. Claims 1-4 were introduced after cancellation of broader claims on prior art. [Deft. Ex. T, pp. 68-74—physical exhibit not printed in the record—R. pp. 361, 362]. They were rejected as inaccurate, indefinite and informal [Deft. Ex. T, p. 83]. These informalities were corrected, and an additional claim, now claim 5 of the patent, was introduced [Deft. Ex. T, pp. 86-87]. All of the claims were then allowed [Deft. Ex. T, p. 95].

It will be observed that in claim 1 the claim specifically provides for a free area between the rear legs, and that the cab enters that free area, and specifies that the rear legs straddle the cab.

In contrast to the specifications of claim 1, claims 2 to 5 are silent as to the presence of a free area between the rear legs and the entry of the cab into the free area. Claims 2-4 state that all four legs straddle the cab, *i.e.*, the front two legs as well as the rear two legs.

In claim 5 the location of the legs and the cooperating structure which supports the legs is not defined in terms of straddling. The claim specifies one pair of front and rear legs and its cooperating structures to one side of the cab and the other pair and its cooperating structures to the other side of the cab. The position of the hinge along the longitudinal axis is specified as adjacent the front axle and above the driver's position.

The specification of claim 5 includes, as well, the position of the hinge above and immediately in front of the cab, as in the accused device [Pltf. Ex. 93, R. p. 355, and Ex. 94, R. p. 356], (Physical Exhibits reproduced on reduced scale in App. B pp. 44-45), as well as its location immediately over the cab as in the form illustrated in the patent [Pltf. Ex. 1, Fig. 3, R. pp. 109, 638, App. B pp. 40-43]. It includes the location of the legs and supporting structure of the accused device, as well as that in the form illustrated in the patent.

The Court of Appeals held that all of these claims (1-5) use substantially the same language to describe the position of the erected derrick relative to the driver's position.

". . . It would seem therefore that in the opinion of the Examiner, the straddling of the cab by the derrick legs was the crux of the invention.

We cannot say that the conclusion of the Examiner in this regard was unwarranted . . . ." [R. p. 907, App. B pp. 7 and 8].

And also:

". . . There is nothing in the record before us to indicate that the examiner in allowing these claims thought that claims two, three, and four established a different specification from claim one. Claim five is consistent with claims one through four. We have no reason to believe it should be read more broadly than the other four claims.

The scope of the invention in this case is set forth clearly in claim one. In accordance with the rule of the Kemart case, supra, we decline to broaden it." [R. pp. 1001 and 1002, App. B, p. 14].

The Court gave to the opinions of the examiner the weight equivalent to a finding of fact by a District Court and placed the burden of proof on the plaintiffs to establish that the examiner intended to grant claims which differed in scope as between themselves. The Appellate Court also stated that:

> "The factual finding of the trial court that the accused devices are not equivalent to the patent claims, as so construed, is not to be disturbed unless clearly erroneous, Graver Mfg. Co. v. Linde Co., 339 U. S. 605, 610. We find no clear error in the making of this finding.
>
> Although the doctrine of file wrapper estoppel was argued before the district court, that court declined to dispose of the case on that ground. In our view it could have done so. The patentee in this case narrowed his claims in order to escape rejection. By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents . . ." [R. p. 1002, App. B p. 14].

The Court of Appeals thus introduced the limitations of claim 1, that the cab enters the free area between the rear legs, into other claims which do not contain this limitation. It refused to the claims the benefits of the doctrine of equivalents to include the accused device, not only because of the conclusion of law #4 that the prior art limited the claims, but also because of a file wrapper estoppel which the District Court declined to employ as a ground for decision.

Reason for Granting the Writ.

Question No. 1.

The decision of the Court of Appeals in limiting the claims 2-5 to be of the same scope as claim 1, in reliance on the asserted doctrine in *Kemart Corp. v. Printing Arts Research Laboratories* (9th Cir. 1953), 201 F. 2d 624, 633 (App. C pp. 63-64), is in conflict with the decisions of this Court in *Smith v. Snow*, 294 U. S. 1, pp. 8, 11, 13-16; 55 S. Ct. 279; 79 L. Ed. 721 (quoted App. C pp. 47-50). It is also in conflict with the decisions of the 2nd Circuit: *Electric Machinery Mfg. Co. v. General Electric Co.* (2nd Cir. 1937), 88 F. 2d 11, 16; cert. den., 301 U. S. 702, 81 L. Ed. 1357 (quoted in App. C pp. 57-58); *Kennedy, et al. v. Trimble Nursery Land Furniture, Inc.* (2nd Cir. 1938), 99 F. 2d 786, 788 (quoted in App. C pp. 59-60); see also *Secretary Pen Co. v. Everlast Pen Corp.* (2nd Cir. 1951), 186 F. 2d 575, 577 (quoted in App. C p. 63). In each of these cases it was held that a claim may not be restricted by introduction of limitation found in other claims and so exclude an accused device.

The decision of the 9th Circuit in this case conflicts in principle with the decision of this court in *Leeds & Catlin v. Victor Talking Machine Co.*, 213 U. S. 301, 318-319, 29 S. Ct. 49, 53 L. Ed. 805, in which the Court pointed out the independent nature of the claims of a patent. It differs also in principle with the following decisions of the 2nd Circuit, which are in consonance with the principle of the decisions cited *supra*: *Western States Mach. Co. v. T. S. Hepworth Co.* (2nd Cir. 1945), 147 F. 2d 345 at pp. 350-351, and cases therein cited (quoted in App. C p. 60); see also *Landis Mach. Co., et al. v. Parker-Kalon Corp. et al.* (2nd Cir. 1951), 190 F. 2d 543,

544. In these cases the 2nd Circuit applied the rule of the independent nature of the claims in considering their validity.

The Supreme Court has stated that such limitation of the claim in order to establish its validity is not permissible. If an unambiguous claim is so broadly stated as to overclaim the invention, it is invalid. *Grazer Tank & Mfg. Co., et al v. Linde Air Products Co.*, 336 U. S. 271, 277, 69 S. Ct. 535, 93 L. Ed. 672, 80 U. S. P. Q. 451, 453.

That a valid claim may not be restricted to exclude an accused device, by imputing to it a limitation that it does not contain by a reference to other claims which do contain this limitation, would appear to be a corollary to the principle stated in *Grazer Tank & Mfg. Co., Inc. v. Linde Air Products*, 339 U. S. 605, 607, 70 S. Ct. 854, 94 L. Ed. 1097, 85 U. S. P. Q. 328. The Court said:

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

It is significant that the Appellate Court referred to no ambiguity in the claims which would require any construction of the language of the claims. It did not rely on the record to construe claims 2 to 5. In fact, the opinion states that the Court found nothing in the record which would, in its view, change the meaning which was apparent to the Court of Appeals [R. p. 1001, App. B p. 14]. Being unambiguous and valid, the claims should have been separately read and separately applied to the accused device, according to their own terms. When so read

claim 5 does not limit the location of the legs so that the cab enter the area between the rear legs. The accused drive-in derrick falls clearly within the claim. There are two legs and cooperating members on each side of the driver's position, and every other element of the claim is present in the accused drive-in derrick.

The error of the Court in its application of the law lies not only in failing to read the claims separately. It lies also in imposing a burden on the patentee to prove affirmatively that the examiner, in allowing, thought that claims two, three and four establish a different specification from claim one [R. pp. 1001-1002, App. B p. 14]. This is an impossible burden. Remembering that the claims were held valid and to contain no ambiguity, this imposes an impossible burden on an applicant. Such doctrine is in conflict in principle with the decisions discussed above under Question I. It is also in conflict in principle with the decisions in other circuits, which hold that the mental processes of the examiner are not binding on the patentee and do not create the file wrapper estoppel. *International Cellucotton Products Co. v. Sterilek Co., Inc.* (2nd Cir. 1938), 94 F. 2d 10, 12 (quoted in App. C p. 58). See also *Hutzler Bros. Co. v. Sales Affiliates, Inc.* (4th Cir. 1947), 164 F. 2d 260, 267.

Question No. 2.

Concededly, it is not sufficient for an accused device to conform to the literal language of the claims. The accused device must not be "so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way," for otherwise, even if it falls within the literal language of the claims, it will not infringe. *Graver Tank & Mfg. Co., Inc. v. Linde Air Products*, 339 U. S. 605, 608

609, 70 S. Ct. 854, 94 L. Ed. 1097, 85 U. S. P. Q. 328, 330, citing *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568 (App. C p. 52).

The Appellate Court believed itself bound by the District Court's conclusion of law #4 [R. pp. 88-91, App. B p. 17] as if it were a finding of fact, basing its decision on *Graver Tank & Mfg. Co., Inc. v. Linde Air Products*, 339 U. S. 605, 610, *supra*. In so doing, the Appellate Court improperly applied the law to the findings of fact and conclusions of law made by the District Court.

The District Court's conclusion of law #4 is without support in any findings that the difference between the accused device and the patented device is more than a colorable difference (See findings and admissions discussed under Question 3). Nonequivalency, in view of the prior art, is present only when the differences between the accused device and the patented device are not mere colorable differences. *Sanitary Refrigerator Co. v. Winters et al.*, 280 U. S. 30, 42; 50 S. Ct. 9, 13; 74 L. Ed. 147 (quoted in App. C p. 54).

Furthermore, it is submitted that this conclusion of law #4, if a finding of fact or a mixed finding of fact and conclusion of law, is a finding of ultimate fact unsupported by any subsidiary findings of fact which establish some more than colorable difference between the function of or result obtained from, or that in the way the accused drive-in units works is different from the patented drive-in unit. In the absence of such findings of fact, the conclusion of law #4 is not sufficient to support a judgment of noninfringement. In concluding otherwise, the Appellate Court's decision conflicts in principle with the decisions of the Supreme Court.

This Court has stated that findings of ultimate facts without supporting findings of fact are insufficient to support a judgment. *Schneiderman v. United States*, 320 U. S. 118, 129, 63 S. Ct. 1333, 87 L. Ed. 796, rehearing denied 320 U. S. 807, 64 S. Ct. 724, 88 L. Ed. 458; *Panama Mail S. S. Co. v. Vargas*, 281 U. S. 670, 50 S. Ct. 448, 74 L. Ed. 1105; *Kelly v. Everglades District*, 319 U. S. 415, 420, 63 S. Ct. 114.

In concluding that the Appellate Court was bound by the conclusion of law #4 made by the District Court without supporting findings, the Appellate Court did not follow its own decisions and practice. *Waialua Co., Ltd. v. Maneja* (9th Cir. 1949), 178 F. 2d 603, 608; cert. den. 339 U. S. 920, 70 S. Ct. 622, 94 L. Ed. 1344; *Hycon Mfg. Co. v. H. Koch & Sons* (9th Cir.), 219 F. 2d 353, 356; *Steccone v. Morse-Starrett Products Co.* (9th Cir.), 191 F. 2d 197, 200; *Warren Graham v. United States* (9th Cir. 1957), 243 F. 2d 919 at p. 923; *Brooks Brothers v. Brooks Clothing of California* (D. C. S. D. of Cal. C. D., 1945), 5 F. R. D. 14 at p. 16; and Judge Yankwich's report to the Judicial Conference of the Ninth Circuit, September 2, 1948, reported in 8 F. R. D. 271, 285. See note 10.

In the absence of subsidiary findings to support the conclusion of law, it is submitted that it was error for the Appellate Court to treat the conclusion of law as a binding finding of fact.

It is submitted that the importance of proper findings of fact, in order to support a judgment of noninfringement, is of such general importance in patent litigation as to merit the consideration of this Court so that it may give direction to the trial courts in infringement cases, as it did in the cases cited above in other fields of law.

Question No. 3.

The Appellate Court erred in not holding that conclusion of law #4 was as a matter of law overborne by the findings of fact made by the District Court. The Appellate Court should have given consideration to the findings of fact as to the similarity and construction of the accused device (See *supra*, App. B pp. 19, 23-26) and the patented device, and to the uncontradicted evidence [R. pp. 271-272, 472], that the accused device and the patented device function in the same way to produce the same results. In fact, if this conclusion of law is a finding of fact it is directly contradicted by the admissions of defendants' attorney in open court, whereby he admitted that the accused device is the equivalent of the patented device [R. pp. 449-500 quoted in App. B pp. 28-30, and particularly bottom of p. 28 and bottom of p. 30]. Such an admission waives necessity of proof of the fact so admitted. *France Mfg. Co. v. Jefferson Electric Co.*, 106 F. 2d 605, 610, citing *Oscanyan v. Arms Company*, 103 U. S. 261, 278, 26 L. Ed. 539.

But certainly, where there are subsidiary findings of fact which show that the accused device and the patented device work in substantially the same way, accomplish the same result, and are the same in function and in structure, the conclusion of law and the judgment upon which it is based cannot be supported. These subsidiary findings of fact are set forth in Appendix B at pages 19 and 23-26. They find a similarity in result, function, mode of operation and structure. The elements of the structure, results obtained, and functions, as stated to be present in the defendants' accused Clipper drive-in unit and in the patent structure, are the very things the Appellate Court stated to be the advance made by the patentee [R. pp. 994-

995, 997, App. B pp. 4-5, and 8]. Even a casual inspection of the exhibits, which the District Court found to show the accused device [See Find. 10, R. p. 89, App. B p. 16 and Pltf. Exs. 93 and 94, R. p. 359, reproduced App. B pp. 44-45] and the figures of the patent [Ex. 1, R. pp. 109, 638, App. B pp. 40-43] will demonstrate the similarity in structure. That the accused device is a mere colorable departure from the patented device appears from the District Court's finding of fact that the defendants in their various structures moved the hinge back and forth with respect to the front axle [R. p. 43, App. B p. 23].

These findings of fact, therefore, overbear the conclusion of law stated by the District Court and relied upon by the Court of Appeals as a finding of fact. From these findings and this inspection, the Court should have found that the issue of infringement is an issue of law *United States v. Esnault-Pelterie*, 303 U. S. 26, 30, 32; 58 S. Ct. 412; 82 L. Ed. 625, *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 36, *supra*.

Petitioners urge that a proper application of the law to the findings of fact made by the trial court would compel a finding of infringement as a matter of law. The evidence is all one way, without contradiction, that the differences between the devices do not change either the functioning of the drive-in units or the way they function, the results they produce. Such differences as exist are mere colorable differences. The accused device and the patented device are the same within the principle of the *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605, *supra* (quoted in App. B pp. 50-54). Thus, having found the patent valid, the judgment destroys the value of the grant by limiting the claims to

the picture shown in the patent. This is in conflict with the principle of law stated in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605, *supra*.

Question No. 4.

(a) *The Appellate Court erroneously applied the rule of file wrapper estoppel and the doctrine of equivalents.*

The Appellate Court applied the rule of file wrapper estoppel to deny to the claims any benefit of the doctrine of equivalents. It stated:

> ". . . The patentee in this case narrowed his claims in order to escape rejection. By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents. D & H Electric Co. v. M. Stephens Mfg. (9th Cir.), 233 F. 2d 879, 883-884." [R. p. 1002, App. B p. 14].

This view, it is believed, arises from a misinterpretation of the Rule of File Wrapper Estoppel as enunciated by the Supreme Court in the leading cases cited by the 9th Circuit in *D. & H. Electric Co. v. M. Stephens Mfg., supra*, and in the following cases not so cited, *Smith v. Magic City Kennel Club*, 282 U. S. 784, 790, 51 S. Ct. 291, 75 L. Ed. 707; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220, 61 S. Ct. 235, 85 L. Ed. 132, 47 U. S. P. Q. 345; *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, 136, 62 S. Ct. 513, 86 L. Ed. 736, 52 U. S. P. Q. 275.

A review of these cases does not support the Appellate Court's construction of the relation of file wrapper estoppel to the doctrine of equivalents. The rule, it is submitted, is not that the patentee in such circumstances is denied the benefit of equivalents, but that "recourse to that doctrine may not be had to recapture claims which

the patentee surrenders by amendment." *Exhibit Supply Co. v. Ace Patents Corp., supra,* at 315 U. S. at p. 137.

However, short of this prohibition, the patentee is entitled to a fair construction of his claims and is not limited to the precise form of the invention by a literal reading of the words of the claims. See *Hubbell v. United States,* 179 U. S. 77 at p. 80, where the Court said:

> ". . . While not allowed to revive a rejected claim, by a broad construction of the claims allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted . . ."

Judge Learned Hand, in his gloss on the rule, has said of the surrender effected by amendment of a broad claim:

> "That surrender does not of course result in a dedication of all species of the genus surrendered; but it does surrender any monopoly upon the genus as such, i.e., unless it be restricted to some species of that genus." *Musher Foundation v. Alba Trading Co.,* 150 F. 2d 885 at p. 888, c.d. 326 U. S. 770, 66 S. Ct. 175, 90 L. Ed. 465 (quoted App. C pp. 61-63).

The Doctrine of Equivalents is a rule of identification. It identifies two forms of the invention which produce the same thing in substantially the same way as the same thing, *i.e.*, the same specie of the invention.

A claim which includes the claimed specie of the invention is not expanded by including its equivalent.

The interpretation of the effect of file wrapper estoppel by the Appellate Court in the present case makes the amendment of a rejected broad claim an abandonment of every variety; *i.e.,* every form of the specie of the

invention other than one literally corresponding to the words of the claim. It denies all benefits of the doctrine of equivalents to the allowed claim.

(b) *The decision of the Appellate Court is in conflict in principle with other decisions of the Supreme Court and with the decisions of the Appellate Courts of other Circuits.*

If the rule of file wrapper estoppel is a rule of abandonment, so is the rule that a claim which does not include all of a patentee's invention abandons the unclaimed subject matter. *Miller v. Brass Co.*, 104 U. S. 350, 352, 26 L. Ed. 783; *McClain v. Ortmayer*, 141 U. S. 419, 423, 12 S. Ct. 76, 35 L. Ed. 1800; *Underwood v. Gerber*, 149 U. S. 224, 231, 13 S. Ct. 854, 37 L. Ed. 710. Yet in the latter case, it obtains the full benefit of the doctrine of equivalents. (*Exhibit Supply Co. v. Ace Patents Corp., supra*, 315 U. S. at p. 136, and *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Corp.*, 339 U. S. 605, at pp. 607-609.)

The Second and the Fifth Circuit construe the intendment of an amendment of a claim to be that the applicant intends to abandon no more than is necessary to distinguish his claim from the prior art. *International Cellucotton Products Co. v. Sterilek Co. Inc.* (2nd Cir. 1938), 94 F. 2d 10, 12, *supra* (quoted in App. C p. 58); *Hunt Tool Co. v. Lawrence* (5th Cir. 1957), 242 F. 2d 347, 354 (quoted in App. C p. 64); see also *Texas Co. v. Globe Oil & Refining Co.* (D. C. N. D. Ill. E. D. 1953), 112 Fed. Supp. 455, 478, 483; affirmed 225 F. 2d 725; *Protective Closure Co. v. Clover Industries* (D. C. W. D. New York 1954), 129 Fed. Supp. 941.

It may be recalled that the only prior art referred to by the Appellate Court was a back-in unit and not a drive-in unit [See R. pp. 994-995, App. B pp. 4-5].

Petitioners submit that file wrapper estoppel is a rule of claim construction. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126, *supra*, at p. 137; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, supra, at p. 220.

If the accused device is an equivalent of the form described in the patent, it being in the eyes of the law the same thing, it must also be included within the claim, whatever be the canon of construction employed. In Judge L. Hand's phrase (*Claude Neon Lights v. E. Machlett & Sons* (2nd Cir. 1929), 36 F. 2d 574 at p. 576), they are both examples of the same class of the invention included in the language of the claim as amended.

The claim is not in any way expanded if it is read to include the accused structures, which differ only in an insubstantial way which has no relation to the functions of or results obtained by, or the way in which the drive-in derricks work.

Petitioners submit that the supervening doctrine which determines issues of infringement as it determines issues of validity of patents is Article I, Sec. 8, clause 8 of the United States Constitution. This clause is for the protection of the inventor as well as for the protection of the public.

When a valid patent has been granted, it must be because the patented invention has advanced the progress of science or the useful arts.

The Appellate Court in this case made a verbal difference between the limited claim 1 introduced after rejection of a broader claim, and the accused device, which does

not affect the substance of the claim, the basis of its holding of non-infringement. In doing so it construed the patent laws in a way which denied to the patentee, rather than to "secure" to the patentee, the exclusive rights to his discoveries.

The reason for the doctrine of equivalents, as stated in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605, 607-608, *supra* (App. C pp. 50-54) apply as well to limited claims inserted by amendment as they do to like claims if originally presented.

Where it has been found that the patent claims are valid, the patent should not be so construed as to permit a fraud to be practiced on the patent. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605, *supra:* We believe that the Ninth Circuit Court of Appeals was correct in its application of this doctrine in *Angelus Sanitary Can Mach. Co. v. Wilson, et al* (9th Cir. 1925), 7 F. 2d 314, 318 (App. C pp. 55-56). It was wrong in this case.

Conclusion.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

PHILIP SUBKOW,

In Propria Persona and
Counsel for Petitioners.

Date: January 14, 1960.

APPENDIX A.

U. S. Constitution, Article I, Sec. 8:

Clause 8. *The Congress shall have Power* * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

U. S. Code, Title 35:

§112. *Specification*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

§271. *Infringement of patent*

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention within the United States during the term of the patent therefor, infringes the patent.

§281. *Remedy for infringement of patent*

A patentee shall have remedy by civil action for infringement of his patent.

§283. *Injunction*

The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.

APPENDIX B.

The Appellate Court's Decision (Record pp. 993-1002).

United States Court of Appeals, for the Ninth Circuit. James Moon, Edmond M. Wagner and Philip Subkow, Appellants, vs. Cabot Shops, Inc., and Howard Supply Company, Appellees.

Cabot Shops, Inc., and Howard Supply Company, Appellants, vs. James Moon, Edmond M. Wagner and Philip Subkow, Appellees.

No. 16,132, September 21, 1959.

Appeals from the United States District Court for the Southern District of California, Central Division.

Before: Barnes, Hamley, and Jertberg, Circuit Judges.

HAMLEY, Circuit Judge:

Plaintiffs Moon, Wagner, and Subkow, as owners of Letters Patent No. 2,671,537, brought this action for damages and injunctive relief against Cabot Shops, Inc., and Howard Supply Company, claiming infringement of their patent.[1] Defendants denied infringement and affirmatively pleaded that the patent is invalid. The patent is invalid, defendants alleged, because the claims of the patent do not evidence invention over the prior art. As additional reasons for challenging the validity of the patent, defendants alleged that the material elements and combination of elements recited in the claims had been disclosed in prior publications and patents, and were in public use for more than one year prior to the filing date of the Moon patent.

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[1]Pursuant to 35 U.S.C.A., §281, and 28 U.S.C.A., §1338(a).

The court, after hearing, adjudged the patent valid but not infringed and dismissed the action. Plaintiffs have appealed from that portion of the judgment holding the patent not infringed; defendants have cross-appealed from that portion of the judgment holding the patent to be valid.

The patent in suit involves a portable derrick of the type used for drilling and servicing oil wells. A telescopic derrick is mounted above the driver's cab at the front end of a truck chassis. An engine is mounted at the rear of the chassis. Winches are positioned between the driver and the engine. A hinge about which the derrick rotates is so positioned at the front of the chassis that when the derrick is transported it lies above the engine and the driver with its bottom to the front of the chassis. Means are provided to rotate the derrick on the hinge so that it may be erected. The derrick is transported in a collapsed position but is extended to working height on erection.

Prior to 1938 the conventional or permanent type of derrick was in common use in most oil fields. Subsequently, Franks Manufacturing Company, the predecessor of Cabot Shops, Inc., produced a portable derrick mounted on a truck chasis. This development made possible the servicing of many wells by a single derrick unit.

The Franks derrick was mounted on a conventional truck chassis with the truck motor at the front and the cab behind the motor. The derrick, of the telescopic type, was hinged at the rear of the truck and erected at that location. Before the derrick could be erected, however, it was necessary to back the truck into position in close proximity to the well head.

It is admitted that although this first portable derrick was a significant achievement it contained several disadvantages inherent in its design.

First among these was the necessity of having to back the truck into position at the well head. The backing process was often time-consuming and difficult to accomplish. Second, this back-in type of derrick presented certain problems with regard to safety. It had only a small margin of stability. Moon testified that he had seen a back-in unit overturn. In addition, the hinging of the derrick at the rear of the chassis created some danger to the driver in the event the derrick should fall back during or after the erection process. Third, the back-in type, because of its weight and arrangement of components, was illegal for transportation over the highways of many states.

Moon filed his patent application June 28, 1948. On October 18, 1949, the Patent Office examiner rejected all the claims on the basis of the prior art. The examiner stated that the Moon structure was merely a reversal of the derrick from the rear to the front of the truck chassis and that such a change was a matter of mechanical expedience and not invention.[2]

This rejection was not acceded to and subsequently amendments and additional claims were filed. These amended and new claims were also rejected by the Patent Office as too broad in view of the prior art.

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[2]The examiner stated in part:

"Applicant has merely taken McEwen's [McEwen patent No. 2,331,558] derrick structure and reversed the position, enclosing McEwen's standards . . . in the cab of the truck and causing the derrick to be raised forward of the truck rather than to the rear of the truck."

On September 15, 1952, Moon requested the cancellation of all prior claims and submitted four new claims. These new claims were more specific with respect to the position of the derrick hinge. The examiner, although objecting to the form of these claims, indicated he would allow three of them if certain changes in language were made. He stated:

"The claims should specifically set forth the particular width relationship of the derrick legs and also the location of the cross bracing elements so as to indicate that the derrick legs will straddle the cab without interference with said cab or cross-bracing. . . ."[3]

Moon acceded to the limitation suggested by the examiner and incorporated it into what is now claim one. The four previous claims were then canceled and four new ones were submitted. Claim five was added subsequently. The patent was granted March 9, 1954.

We turn first to the question of patent validity.

A presumption of validity arises from the issuance of a patent.[4] The presumption is predicated upon the expertness of the Patent Office acting within its specific field, and can be overcome only by clear and convincing proof. The burden of proof in such cases is upon the party attacking the patent, and reasonable doubts must be resolved in favor of validity. See Patterson-Ballagh Corp. v. Moss, 9 Cir., 201 F. 2d 403, 406.

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[3]The examiner also specified as follows:

". . . The rear legs of the derrick, as set forth in the specification and not the front legs, as stated in line 19 of claim 17, straddle the cab. . . . Upon satisfactory correction of claims 14, 15 and 17 along the lines indicated above such claims appear to be allowable."

[4]35 U.S.C.A., § 282; Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co., 9 Cir., 151 F. 2d 91, 94.

Defendants question the validity of the patent in suit on three grounds. They claim that Moon's structure is nothing more than a collection of elements old in the art combined in an obvious manner to produce an obvious result. Further, they contend that his structure lacks invention over the prior art. Finally, they maintain that the patent in suit was described in printed publications published more than one year prior to the filing of the application for the patent.[5]

The district court found that the structure described in the patent represented an inventive advance over the prior art. It also found that the invention of the patent was not patented or described in a printed publication more than one year prior to the filing of the application for the patent. It concluded that the patent was validly issued.

Defendants argue specifically that the only novelty involved in the patented structure is in the straddling of the driver's position by the derrick legs, and they deny that such straddling amounts to invention. They contend that such straddling is neither useful, desirable, nor advantageous.

Our review of the Patent Office proceedings convinces us that the examiner found the inventive feature of the Moon structure to be in the positioning of the derrick so that the legs straddle the driver's position. As before noted, the examiner rejected Moon's earlier claims on the ground that they were merely reversals of the prior art. When Moon qualified his claims, however, so that provision was made for the legs to straddle the driver's position, the claims were allowed. It would seem therefore

[5]This contention is premised on 35 U.S.C.A., § 102(b).

that in the opinion of the examiner the straddling of the cab by the derrick legs was the crux of the invention.

We cannot say that the conclusion of the examiner in this regard was unwarranted. The Moon structure solved many of the problems posed by the back-in units. The derrick as combined with the chassis and the cab produced a structure which was at once stable, safe, and maneuverable. It was the interaction of the derrick with the chassis and the cab position as described in the claims that made for patentability in this case. It was that interaction which produced the desired stability, safety, and maneuverability not previously achieved by any portable derrick unit.

We cannot agree with defendants that the Moon structure lacks invention over the prior art. None of the cited prior art patents teaches the value of positioning the derrick so that its legs straddle the cab. None solves the problems of stability, safety, and maneuverability. In solving these problems, Moon's structure went beyond the prior art.

Defendants contend that the patent in suit is invalid by reason of prior publication. The district court found that the patent in suit had not been patented or described in any printed publication more than one year prior to the filing date of the patent in suit. Defendants argue that this finding is clearly erroneous because a number of pictures or sketches of the Moon structure were published more than a year before the application was filed. They argue that the pictures or sketches disclose the structure of the patent. The district court found that it was not clearly apparent from the evidence that the printed publications embodied the invention of the patent in suit.

The pictures or sketches of the Moon device in the printed publications show, with one exception, the derrick in its collapsed and horizontal position on top of the chassis. The pictures or sketches are of an advertising nature and are not detailed. In none of them is the hinge position clearly shown. Nor is it apparent that the driver's cab enters between the derrick legs. Numerous other details have also been omitted and must be filled in by the observer's imagination. In addition, the expert testimony of engineers as to what these pictures or sketches disclose was in conflict. The resolution of that conflict was for the trial court. It resolved it against the defendants. We do not think its finding on this point was clearly erroneous.[6]

We hold that the trial court did not err in concluding that Moon's structure involved invention and that the patent was validly issued.

We turn now to the matter of infringement.

Plaintiffs claim the defendants' structures infringe their patent in that they are not different in any substantial degree, and function in the same manner to produce the same results as the equivalent structures illustrated in the drawings of the patent in suit. The court below found that the defendants' structures do not infringe. It concluded that in view of the prior art the scope of plaintiffs' invention should be closely limited and the claims given only a narrow range of equivalents. Applying such a narrow range of equivalents, it determined that the accused devices were not included in that range.

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[6]Our determination on this point makes it unnecessary for us to decide whether the trial court erred in concluding that the filing date of the patent application could not be carried back to an earlier date.

Plaintiffs specify as error the above conclusions of the district court. We must, at the outset, therefore, consider the correctness of its ruling on the allowable range of equivalents.

The doctrine of equivalents gives to a patentee the benefit of his monopoly in every form in which it may be copied in the absence of manifest disclaimer, but the range of equivalents can in no event be more than commensurate with the scope of the patentee's invention. Etten v. Kauffman, 3 Cir., 121 F. 2d 137, 140. In determining the permissible range of equivalents, the court must consider the state of the prior art, the novelty and contribution of the claimed invention, the nature and extent of the differences between the patented and the accused devices, the scope of the claim of the patent and the limitations in it, and other surrounding circumstances. Long Mfg. Co. v. Holliday, 4 Cir., 246 F. 2d 95, 100.

The trial court had before it the prior art. It also had before it the proceedings before the patent examiner. It was aware of the history of this patent application. It was aware of the fact that Moon's claims had been rejected and amended several times before some were finally allowed. And it was also aware of the express limitation proposed by the examiner as a condition to the allowance of the patent claims. In our opinion the trial court did not err in determining that the patent should be restricted to a narrow range of equivalents.

We must next consider whether the accused structures come within this narrow range of equivalents.

As noted above, the invention of the patented structure is the positioning of the derrick so that its legs straddle the cab or driver's position. In order for the

derrick legs to straddle the cab the derrick hinge must be positioned above the driver's position.

Defendants contend they do not infringe because they have moved the hinge forward (or the cab backward) so that the legs of the derrick do not straddle the cab. Plaintiffs maintain that this forward shift of the hinge (or backward shift of the cab) is merely an immaterial change in form and that it does not change the results obtained or the manner or means by which such results are obtained. It is plaintiffs' position that the accused structures are the full equivalent of their structure.

Defendants admit the similarity of the structures, but they argue in substance that the Moon patent is limited by its straddling feature and that it is necessarily restricted in its claims to that form.[7] The claims which Moon originally sought to obtain from the Patent Office, defendants admit, would definitely be infringed by their structures.

It thus becomes necessary for us to analyze and construe the claims of the patent. In doing so, we are mindful of certain well-established rules of construction. Claims of a patent must be construed not only in the light of the specifications and drawings, but also with reference to the file wrapper history. Whiteman v. Mathews, 9 Cir., 216 F. 2d 712, 715. That is, the claims of the patent must always be explained by and read in connection with the specifications and in the light of definitions and admissions made by the applicant in the proceedings in the Patent Office. Westinghouse Electric Corp. v. Hanovia Chemical & Mfg. Co., 3 Cir., 179 F. 2d 293, 296-297. And a claim must be read and interpreted with reference

[7] See American Seating Co. v. Ideal Seating Co., 6 Cir., 124 F. 2d 70.

to claims which have been rejected. Claims which have been allowed cannot, by construction, be read to cover what has been thus eliminated from the patent. Hall v. Wright, 9 Cir., 240 F. 2d 787, 794.

Defendants argue that claim one of the patent defines the scope of the invention. They contend its limitations should be read into the four other claims. Plaintiffs, on the other hand, contend that claim one is narrower than the others and should not be read into them.

This court, in Kemart Corp. v. Printing Arts Research Laboratories, 9 Cir., 201 F. 2d 624, 633, held that in interpreting a series of claims, a limitation not present in one claim must not be implied although it appears in later claims. The reason for this rule, we stated, is that each claim is in theory a separate patent. But "this rule of construction is subordinate to the controlling rule that a patentee's broadest claim can be no broader than his actual invention, no matter how it may be expressed or what other claim his patent may contain."

As before noted, claim one was expressly drawn to accomodate the proposal of the examiner that the claims specifically state the relationship of the derrick legs to the cab.[8] In their brief the plaintiffs admit that this limitation was incorporated into claim one, but deny it was incorporated into the other claims. They deny that in claims two through five the driver's position is required to be within the area bounded by the derrick legs.

Claim two reads:

". . . [the derrick] leg portions and said hinge being positioned with respect to the longitudinal axis of said chassis (a) locating said driver's position between the

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[8]See footnote 3, supra.

said leg portions with (1) the said leg portions straddling said driver's position when the derrick is in said erect position."

Claim three reads:

". . . with said [derrick] leg portions straddling said driver's position when the derrick is in erect position."

Claim four reads:

". . . said [derrick] leg portions . . . being located with respect to the longitudinal axis of said chassis (1) causing a portion of the driver's position to be positioned between the said leg portions, (2) said leg portions extending from said hinge to rest on the ground and straddle said driver's position with the derrick in said erect position. . . ."

Claim five reads:

". . . 1. locating said lower ends of one pair of front and rear legs . . . a. to one side of said driver's position and b. the lower ends of the other pair of front and rear legs . . . to the other side of said driver's position c. with the derrick in said erect position."

It appears from the quoted portions of the claims that the straddling feature found in claim one is present in each of them. Plaintiffs contend, however, that the straddling concept as used in claims two, three, and four really means that two legs of the derrick are on one side of the driver and two are on the other. Their contention is, in other words, that the concept of straddling does not require the entry of the cab into the area directly between the two rear legs of the derrick. With respect to claim five, they argue that since it does not contain the word "straddle" it clearly is broader and should not be limited to the specification of claim one.

In our view plaintiffs have ignored the meaning of the straddling language as used in claims one through four. These four claims use substantially the same language to describe the position of the erected derrick relative to the driver's position. There is nothing in the record before us to indicate that the examiner in allowing these claims thought that claims two, three, and four established a different specification from claim one. Claim five is consistent with claims one through four. We have no reason to believe it should be read more broadly than the other four claims.

The scope of the invention in this case is set forth clearly in claim one. In accordance with the rule of the Kemart case, supra, we decline to broaden it.

The factual finding of the trial court that the accused devices are not equivalent to the patent claims, as so construed, is not to be disturbed unless clearly erroneous. Graver Mfg. Co. v. Linde Co., 339 U. S. 605, 610. We find no clear error in the making of this finding.

Although the doctrine of file wrapper estoppel was argued before the district court, that court declined to dispose of the case on that ground. In our view it could have done so. The patentee in this case narrowed his claims in order to escape rejection. By thus limiting his claims, he is estopped to enlarge them by resort to the doctrine of equivalents. D & H Electric Co. v. M. Stephens Mfg., 9 Cir., 233 F. 2d 879, 883-884.

The patent in suit is valid but not infringed.

Affirmed.

(Endorsed:) Opinion. Filed Sept. 21, 1959.

Paul P. O'Brien, Clerk.

In the United States District Court, Southern District of California, Central Division, Civil Action No. 28057-WM.

JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW, Plaintiffs, vs. CABOT SHOPS, INC., *et al.*, Defendants.

Findings of Fact, Conclusions of Law and Judgment (Record pp. 88-91).

This Cause coming on to be heard, and the plaintiffs and defendants having offered evidence, both documentary and oral, and the Court being fully advised hereby enters the following findings of fact, conclusions of law and judgment.

Findings of Fact

1. By this action, plaintiffs James Moon, Edmond M. Wagner and Philip Subkow, joint owners of United States Letters Patent No. 2,671,537 seek, against defendants Cabot Shops, Inc. and Howard Supply Company, an injunction and damages by reason of the alleged infringement by the defendants.

2. The Court adopts as the findings of fact each statement admitted to be true in the Pretrial Conference Order entered March 3, 1958, Item III, 1 through 19, including each statement of fact referred to in Item III (12) as fully as if each such statement were set forth verbatim herein.

3. Mr. Moon made the invention claimed by the patent in suit December 12, 1946.

4. The invention claimed in the claims of the patent in suit was not patented or described in any printed publication (Exhibits M through T, both inclusive) cited

by the defendant Cabot Shops, Inc. in its Answers to Plaintiffs' Interrogatories No. XIII, dated March 20, 1958 and filed March 21, 1958.

5. It does not clearly appear from the evidence that the devices described in the printed publications embody the invention of the patent in suit, the details not being apparent from the advertisements (Exhibits M through R).

6. The invention of the patent in suit was not patented or described in a printed publication cited by the defendant Cabot Shops, Inc. in its Answers to Plaintiffs' Interrogatories as set forth in Finding No. 4 more than one year prior to the filing of the application for the patent in suit.

7. The application of the patent in suit does not contain any caveat on the face of the issued Letters Patent giving notice of any claim to any filing date earlier than the filing date of the patent in suit.

8. Mr. Moon filed on February 24, 1948 an application for Letters Patent, Exhibit 46.

9. The invention described in the patent represents an inventive advance over the prior art.

10. The defendants' drive-in units are correctly shown at page 1810 of Exhibit 55 and pages 1883, 1884 and 1885 of Exhibit 54 and in Exhibits 57, 59, 93, 94 and 95.

11. Said drive-in units referred to in Finding No. 10 do not infringe the claims of the patent in suit.

Conclusions of Law

1. The plaintiffs are the owners of the patent in suit.

2. The patent in suit and each claim thereof is good and valid in law.

3. Plaintiffs are not entitled to carry the effective filing date of the patent in suit to February 24, 1948, the filing date of the application Exhibit 46.

4. In view of the state of the prior art the scope of the invention should be closely limited and so that the claims are entitled to a very narrow range of equivalents and the said range of equivalents does not include the accused devices of defendants.

5. None of the claims of the patent in suit are infringed by the drive-in units referred to in Finding of Fact No. 10.

Judgment

In accordance with the foregoing Findings of Fact and Conclusions of Law, it is Adjudged and Decreed:

1. The patent in suit and each of the claims thereof is good and valid in law.

2. None of the claims of the patent in suit have been infringed by defendants.

3. The complaint herein be and the same is hereby dismissed, and plaintiffs shall take nothing thereby.

4. Each party shall bear its own costs, and there shall be no award of attorneys' fees.

Dated at Los Angeles, California this 7th day of June, 1958.

/s/ WM. C. MATHES,
United States District Judge.

Statements appearing in Pretrial conference order adopted as findings of fact.

Pre-Trial Conference Order (Record pp. 57-64).

I.

The parties to this action are James Moon, Edmond M. Wagner and Philip Subkow, owners of the patent by mesne assignment. The defendants are Cabot Shops; Inc., a Massachusetts corporation, and Howard Supply Company, a California corporation. The pleadings are a Complaint filed February 27, 1957, as amended by Stipulation and Order dated January 3, 1958, and an Answer served March 29, 1957, which Answer by said Stipulation and Order constitutes the Answer to said Complaint as amended.

II.

Federal jurisdiction is invoked on the ground that this is an action for infringement of the patent under the Patent Laws of the United States, Title 35 U. S. C. and under Title 28 U. S. C., Section 1338(a).

III.

The following facts are admitted, and require no proof:

. . .

12. The Statement of Facts, appearing in only the following portion of Plaintiffs' Pre-Trial Statement of Facts, on file in this case and herein incorporated by this reference to the extent herein specified: Statements appearing in Paragraphs 2 and all its subdivisions, 3 and all its subdivisions, 4(a), 5(a), (b), and (c); 8, 13(a) and (b), 14(a) and (b), 16 and all its subdivisions, 17, 21(a), 24(a), 48(a) and (b), 49 and all its subdivisions, 50(a), (b), (d) and (e), 52(a) and (d) and all subdivisions of (d), 53 and all its subdivisions, 54(a), 55, including A, B, C, D, H, I, J, L and subdivisions (a) (b), (c) and (d), and 58.

16. Conventional trucks as used in the construction of back-in units in which the derrick was carried to be hinged on the rear of the vehicle were not suitable to carry heavier derricks of the telescopic type. Not only were their structural characteristics insufficient, but the weight distribution was also unsuitable for engineering and legal reasons; the legal reasons being the necessity for compliance with the various highway codes of the various states. In building the drive-in units in which the derrick is hinged at the front of the truck it became feasible to custom build the unit to obtain a weight distribution which would be desirable and which would satisfy both engineering and legal requirements for such structure.

17. The statement of facts appearing in the following portions only of the defendants' Pre-Trial Opening Statement on file in this Court, to wit: Paragraphs 4, 6 and 8, which are hereby incorporated by this reference.

* * *

IX.

The foregoing admissions having been made by the parties, and the parties having specified the foregoing issues of fact and law remaining to be litigated, this order shall supplement the pleadings and govern the course of the trial of this cause, unless modified to prevent manifest injustice.

Dated: March 3, 1958.

/s/ WM. C. MATHES,
United States District Judge.

Approved as to form and content:

/s/ PHILIP SUBKOW,
Attorney for Plaintiffs.

LYON & LYON,
/s/ By CHARLES G. LYON,
Attorneys for Defendants.

Statements appearing in Plaintiffs' Pre-Trial Statement of Facts. [R. pp. 28-49] adopted by reference in Paragraph III-12 of Pre-Trial Conference order [See R. pp. 28-32, 34-35, 41-47, 49].

* * *

Plaintiffs' Pretrial Statement of Facts (Record pp. 28-49).

* * *

2. (a) Prior to 1948, portable derricks employed for servicing and drilling oil wells of the telescopic lattice or trussed four-legged type, were of the back-in type.

(b) These are so called because a derrick was transported and mounted on the vehicle so that it was hinged at the back end of the vehicle. The driver and engine were positioned at the front end of the vehicle. The vehicle had to be backed into the location in order to erect the derrick.

3. (a) Pole masts were also employed.

(b) These pole masts were so called because in their early design they consisted of a single tube which in some cases was telescopic and which was mounted upon a vehicle.

(c) These pole masts were mounted on vehicles either to pivot on the rear of the vehicle in a "back-in" type or in early types to pivot at the front of the vehicle in a "drive-in" type.

* * *

5. (a) Later a pole mast was hinged on the front end of the tractor above the drum and forward of the drum.

(b) This permitted the tractor with the hoist and pole mast to be driven directly to the well site instead of backing in.

(c) The driver still sat at the rear of the tractor with the hoist on the front end and the engine between him and the hoist and the pole hinge.

* * *

8. Double pole masts of the telescoping type also were used.

* * *

13. (a) The portable telescopic truss-type derricks of the back-in kind were substituted for permanent derricks previously employed in many instances.

(b) Because of their versatility they also replaced pole type masts in many services for which pole type masts had been used previously.

14. (a) Defendant's predecessor, Franks Manufacturing Co., manufactured and sold a telescopic truss-type back-in truck mounted derrick in 1939.

(b) Previously it had built back-in derricks which were not telescopic and were designed for light service in which they used hydraulic jacks to erect the derrick.

* * *

16. One of the difficulties with the back-in units was that they did not comply with highway laws of the various states in that they could not be built so as to comply with:

(a) The limitations of loading on the front or rear wheels; or with

(b) The overhang requirements, or overall height requirements.

17. Additionally, the position of the derrick was such that the top of the derrick had to protrude in front of the vehicle for more than was allowable under the highway laws of many states.

* * *

21. (a) Users of back-in derricks demanded that they be supplied with units that they could move over the road at any time without special permit without interference by the police.

* * *

24. (a) Defendant's predecessor, the Franks Manufacturing Corp, for long prior to the construction by Franks of its first Clipper unit had knowledge of the illegality of the back-in units.

* * *

48. (a) September of 1946, Franks Transportation Co. learned of Moon's concept of the drive-in unit.

(b) However, admitting that the design appeared ingenious, Mr. Woody, then Vice President in charge of Engineering of Franks, doubted its practicality and believed that the weights would be excessive.

49. (a) By 1949, the problem of the illegality of the back-in units became so acute that they were forced by competition from Waldrip to attempt to design a legal unit.

(b) Franks first tried to modify the back-in unit previously manufactured by them in order to make it comply with the Highway laws but failed to solve the problem by this method.

(c) They sent an engineer to California to design a legal unit.

(d) His designs constituted a modification of the back-in unit which was found to be entirely unsuitable by Franks.

50. (a) During and prior to the completion of the design of the first Clipper unit by Franks they had learned

of the Moon design of the drive-in unit manufactured by Waldrip.

(b) They had obtained a copy of a brochure prepared by Moon for Waldrip.

* * *

(d) The units manufactured by Waldrip were then in the field and in use.

(e) Waldrip had advertised these units.

* * *

52. (a) Franks subsequently designed various models employing two and four front wheels and moving the hinge point back and forth with respect to the front axle.

* * *

(d) They are severally identified and advertised in the catalogues of defendant Cabot Shops, Inc., as follows:

(i) Midget Clipper, shown at page 1810 of the 1956 catalogue;

(ii) Giant Clipper, shown at page 1883 of the 1957 catalogue;

(iii) Super Senior Clipper, shown at page 1884 of the 1957 catalogue;

(iv) Senior Clipper, shown at page 1885 of the 1957 catalogue.

53. (a) At least 16 of such units were sold since March, 1954 and prior to filing of this action, and at least one thereof was sold in the Southern District of California.

(b) That at all such times Franks and subsequently defendant, Cabot Shops, Inc., maintained an established place of business in Los Angeles County.

(c) That on or about the 5th day of April, 1955, said Franks Manufacturing Corp. did merge with Cabot Shops, Inc., the herein defendant, and acquired all liabilities of said Franks Manufacturing Corp.

(d) That defendant, Cabot Shops, Inc., does not claim any ownership or any part of the right, title and interest in or to said Letters Patent 2671537, or in or to the invention and discovery secured thereby or any shop right, or any other right or license thereunder or thereto.

54. (a) Defendant, Howard Shops, Inc., is a California corporation, having its principal place of business in Los Angeles County, has been and is now and prior to the filing of this Complaint was the sales representative of Cabot Shops, Inc., a defendant herein, and joined with defendant, Cabot Shops, Inc., in the sales made in the said Southern district of California.

* * *

55. These "Clipper units" all have the following characteristics also possessed by the structure described in the Moon Patent:

A. The derrick is a four-legged truss type lattice telescopic derrick which when erected to the vertical position at the front of the vehicle, has its axis inclined to the perpendicular.

B. The derrick when erected, is capable of carrying the loads imposed on the derrick and to transmit the loads to the ground through structure elements which include the derrick legs.

C. The derrick load transmitting structure is such that the base of the derrick is larger than the cab dimension measured transversely of the cab.

D. This structure includes also framing for the hinge point so as to carry load on the derrick legs to the ground through a framework which transmits the load to the chassis and from the chassis through jacks to the ground.

* * *

H. The position of the hinge and the location of the derrick erecting mechanism is such that the mechanism transmits the erecting load to the chassis between the front axle and the rear axle.

I. The load of the derrick as it is erected and moves towards its perpendicular position is transmitted to the chassis to the ground and produces a load distribution resulting in a chassis frame deflection which is well within the allowable strain in the structure.

J. By positioning the engine at the rear of the vehicle and hinging the derrick at the front of the vehicle, the center of mass of the structure is moved towards the rear side of the center line of the vehicle, thus giving to the drive-in unit stability during raising and in use.

* * *

L. The arrangement with the motor at the rear of the truck and with the crown of the derrick to the rear of the truck and with the cab at the front of the truck has also the following advantages:

(a) By placing the driver next to the base of the derrick, he can spot the derrick by driving directly to the desired location;

(b) The arrangement of the parts makes it possible to limit the front leg extension to any desired amount in front of the vehicle by providing cooperating structure to carry the load to the ground;

(c) Room is provided on the truck for the hoist and also room for positioning the erecting jack and room for its rotation to erect the derrick;

(d) The arrangement provides room for positioning the major weight on the rear wheels and provides room for shifting the motor and hoist so as to place the right proportion of the weight on the rear and front wheels.

* * *

58. The following have been licensed under the patent in suit:

Hopper Machine Works, Inc.
Ideco Division, Dresser Equipment Co.
Wagner-Morehouse, Inc.

* * *

Statement of fact appearing in Defendants' Pre-Trial Opening statement adopted by reference in Par. 17 of the Pre-Trial Order [R. p. 61 and R. p. 49, pp. 51 and 52.]

* * *

4. Portable truck-mounted rear-erecting telescoping derricks were quite common at least two years prior to the application of Moon for the patent here in suit. So too, were the elevating mechanisms for erecting the derricks and extending and retracting the telescopic sections (Carl White Patent No. 2,204,713).

* * *

6. Most of the truck-mounted, portable masts or derricks constructed prior to World War II were built upon so-called standard truck chassis; that is, chassis which were available from standard truck manufacturers and which required certain modification or reinforcement to carry the portable derricks.

* * *

8. Prior to June 28, 1947, that is, prior to one year before the filing of the application for the patent in suit, Waldrip Engineering Company published or caused to be published product announcements of a self-propelled portable derrick in the following:

"Oil Weekly," May 5, 1947

"Oil and Gas Journal," May 10, 1947.

* * *

[Vol. II, R. pp. 499-501.]

The Court: The accused device does not straddle the driver? It straddles the cab, is that it?

Mr. Kenway: Yes, sir. In all of the defendants' devices, and in the devices actually constructed by Waldrip, that hinge point was moved forward so that it was at the extreme upper front corner of the cab structure, and, therefore, the derrick was out in front of the cab and driver's position.

The Court: Completely?

Mr. Kenway: Substantially so.

The Court: Of course, in the drawing in Figure 3, I suppose it is substantially so, isn't it?

Mr. Kenway: Well, if your Honor looks at Figure 3, you will see perhaps half the cab is actually within the confines of the derrick itself.

The Court: Yes, but as long as it straddles the cab at all, wouldn't that meet the claim?

Mr. Kenway: No, sir.

The Court: In order to avoid infringement on that point, wouldn't you have to be able to say you did not straddle the cab at all?

Mr. Kenway: We say in view of the file wrapper we don't straddl the cab. This is the peculiar thing. It doesn't make much sense from a common sense viewpoint, at least, it doesn't to me. I don't see much difference between—

The Court: You mean the file wrapper limits the patentee to the point where he has to say that an infringer substantially straddles the cab?

Mr. Kenway: Yes, sir, that is quite evident from the file wrapper.

The Court: And not just in a small degree, but in a large degree,—a half or better?

Mr. Kenway: Yes, sir.

The Court: Is that what you were saying?

Mr. Kenway: Yes, sir.

The Court: If only 25 per cent straddles the cab, do you say it avoids infringement?

Mr. Kenway: Well, it is difficult to draw the line.

The Court: Well, we have to draw it, don't we?

Mr. Kenway: I think we can do that.

The Court: Must we not, and isn't it absolutely imperative that we draw the line?

Mr. Kenway: Yes, sir.

The Court: And unless you can say our device—the derrick in our device does not straddle the cab at all, so that we don't do that at all?

Mr. Kenway: Well, that is the case.

The Court: Then I misunderstood you. I thought you said that you did straddle it a little bit.

Mr. Kenway: No, sir. I didn't mean to say that.

The Court: Not even a tiny bit, and not at all?

Mr. Kenway: I thought you were talking about the Waldrip construction. I am sorry.

The Court: Oh, I am sorry. I probably misled you. Does the accused device straddle the cab at all?

Mr. Kenway: No, sir.

The Court: So that you say that the plaintiffs' combination is such that in order to build it as taught in the patent, the legs of the derrick do straddle the cab; is that correct?

Mr. Kenway: In order to build a unit which meets the language of the claims, you have to have that derrick straddling the cab, yes, sir.

The Court: And your answer to that, as I understand it, is even though we use the same combination, it is different to the extent that the legs of our derrick do not at all straddle the cab.

Mr. Kenway: Yes, sir.

The Court: So, therefore, the claims cannot, as we say, read on our device is that it?

Mr. Kenway: Yes, sir, that is just what we do say.

The Court: The file wrapper does not have any thing to do with that, does it?

Mr. Kenway: Oh, yes, it does, your Honor.

The Court: Except as limiting the scope of the claims?

Mr. Kenway: Well, you have—

The Court: Assume there is nothing in the file wrapper, wouldn't you make the same contention?

Mr. Kenway: No, I don't think I could.

The Court: Why? Because this would be a substantial equivalent: is that it?

Mr. Kenway: Yes, precisely so. You heard Mr. Mo testify that our construction was the substantial equivalent of what is called for in the claims.

Exhibits 1-A, pp. 647-656 of Vol. III.

* * *

PLAINTIFF'S EXHIBIT No. 1-A

MOON PATENT No. 2,671,537

Claim 1:

A portable derrick comprising

A. a chassis,

B. front wheels mounted on an axle positioned adjacent to the front end of the chassis,

C. rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. a driver's position with steering and motive power controls positioned adjacent the front end of said chassis and extending forward of the front axle,

E. a collapsible and extensible derrick pivotally mounted on the chassis to move from a rest position on said chassis with the top end of the derrick positioned rearwardly of said chassis and the bottom of said derrick being positioned on said chassis toward the front end of said chassis,

(a) spaced two front and two rear legs for said derrick, cross bracing between said legs

(1) with a free area between a portion of the rear legs,

(b) said derrick comprising a lower section and an upper section,

F. means for moving said upper section relative to said lower section to extend and to collapse said derrick.

G. a hinge on said derrick positioned near the bottom end of said derrick,

(a) said hinge also positioned on said chassis intermediate the forwardmost limits of said chassis and the front axle and above said driver's position, and

H. means for rotating said derrick about said hinge to an erect position adjacent the front end of said chassis,

(a) said means including a rotation power transmitting member connected to said derrick at a point on said derrick spaced from said hinge,

(1) said transmitting member transmitting rotative power to said derrick to rotate said derrick about said hinge,

I. and a load transmitting connection between said member and said chassis,

(a) said connection being positioned on said chassis between said front and rear axles,

J. lower portions of said legs being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position,

K. and said lower leg portions and said hinge being located with respect to the longitudinal axis of said chassis

(a) to cause a portion of the driver's position to enter said free area and

(b) the lower rear leg portions to straddle said driver's position when the derrick is in said erect position.

Claim 2:

A portable derrick comprising

A. a chassis,

B. front wheels mounted on an axle positioned adjacent the front end of the chassis,

C. rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. a driver's position with steering and motive power controls positioned adjacent the front end of said chassis,

E. a collapsible and extensible derrick pivotally mounted on the chassis to move from a rest position on said chassis with the top end of the derrick positioned rearwardly of said chassis and the lower end of said derrick being positioned on said chassis toward the front end of said chassis,

(a) spaced two front and two rear legs for said derrick, cross bracing between said legs,

(b) said derrick comprising a lower section and an upper section,

F. means for moving said upper section relative to said lower section to extend and to collapse said derrick,

G. a hinge on said derrick positioned adjacent the lower end of said derrick,

(a) said hinge also positioned on said chassis intermediate the forwardmost limits of said chassis and the front axle and above said driver's position, and

H. means for rotating said derrick about said hinge to an erect position adjacent the front end of said chassis

(a) with the lower end of said derrick legs in load transference relation to the ground,

(b) said means including

(1) a rotation power transmitting member connected to said derrick at a point on said derrick spaced from said hinge, said transmitting member trans-

mitting rotative power to said derrick to rotate said derrick about said hinge, and

I. a load transmitting connection between said member and said chassis,

(a) said connection being positioned on said chassis between said front and rear axles,

J. the portions of said legs in load transference relationship to the ground being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position, and

K. said leg portions and said hinge being positioned with respect to the longitudinal axis of said chassis

(a) locating said driver's position between the said leg portions with

(1) the said leg portions straddling said driver's position when the derrick is in said erect position.

Claim 3:

A portable derrick, comprising

A. a chassis,

B. front wheels mounted on an axle positioned adjacent the front end of the chassis,

C. rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. a driver's position with steering and motive power controls positioned adjacent the front end of said chassis,

E. a motive power unit positioned on said chassis rearward of said driver's position,

F. winches positioned on said chassis rearward of said driver's position,

G. a derrick pivotally mounted on the chassis to move from a rest position on said chassis with the top end of the derrick positioned rearward of said chassis behind said cab, the bottom of said derrick being positioned on said chassis toward the front end of said chassis,

H. a hinge on said derrick positioned near the bottom end of said derrick,

(a) said hinge also positioned on said chassis intermediate the forwardmost limits of said chassis and said front axle and

(b) above said driver's position, and

I. means for rotating said derrick about said hinge to an erect position adjacent the front end of said chassis,

J. said derrick including spaced two front leg members and two rear leg members, cross bracing between said leg members,

(a) said derrick legs being in load transference relationship to the ground when said derrick is in erect position,

(b) the derrick axis being positioned in a slant plane with respect to the perpendicular as to cause the axis of said derrick to bear away from said chassis at an acute angle to the verticle when said derrick is in an erect position,

(c) portions of said derrick supporting legs resting on and in load transference relationship to the ground when the derrick is in erect position being

(1) spaced apart transversely with respect to said chassis a distance greater than the transverse extent of the forwardmost portion of said chassis, and

K. leg portions and said hinge being positioned with respect to the longitudinal axis of said chassis locating

the portion of said legs in said load transference relationship to the ground below said forwardmost portion of said chassis

(a) with said last-named leg portions straddling said driver's position when the derrick is in erect position.

Claim 4:

A portable derrick, comprising

A. a chassis,

B. front wheels mounted on an axle positioned adjacent the front end of the chassis,

C. rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. a driver's position with steering and motive power controls positioned adjacent the front end of said chassis,

E. a motive power unit positioned at the rear end of said chassis,

F. a winch positioned between said motive power unit and the driver's position,

G. a collapsible and extensible derrick pivotally mounted on the chassis to move from a rest position

(a) on said chassis above said motive power unit and said winch

(b) with the top end of the derrick positioned rearwardly of said chassis and the bottom of said derrick being positioned on said chassis toward the front end of said chassis,

(c) spaced two front and two rear legs for said derrick, cross bracing between said legs,

(d) said derrick comprising a lower section and an upper section,

H. means for moving said upper section relative to said lower section to extend and to collapse said derrick,

I. a hinge on said derrick positioned adjacent the lower end of said derrick,

(a) a hinge support positioned on said chassis adjacent the front axle and supporting said hinge above said driver's position, said motive power unit and said winch, and

J. means for rotating said derrick about said hinge to an erect position adjacent the front end of said chassis, said

(a) means, including a rotation power transmitting member connected to said derrick at a point on said derrick spaced from said hinge,

(b) said transmitting member transmitting rotative power to said derrick to rotate said derrick about said hinge,

K. and a load transmitting connection between said member and said chassis,

(a) said connection being positioned on said chassis between said front and rear axles,

L. said derrick legs being in load transference relation to the ground when said derrick is in an erect position,

(a) portions of said legs which are resting on the ground when the derrick is in an erect position being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position, and

(b) said leg portions and said hinge being located with respect to the longitudinal axis of said chassis

(1) causing a portion of the driver's position to be positioned between the said leg portions,

(2) said leg portions extending from said hinge to rest on the ground and straddle said driver's position with the derrick in said erect position with the hinged derrick in load transference relationship to the ground.

Claim 5:

A portable derrick, comprising

A. a chassis,

B. front wheels mounted on an axle positioned adjacent the front end of the chassis,

C. rear wheels mounted on an axle positioned adjacent the rear end of the chassis,

D. a driver's position with steering and motive power controls positioned adjacent the front end of said chassis,

E. a motive power unit positioned at the rear of said chassis,

F. a collapsible and extensible derrick pivotally mounted on the chassis to move from a rest position on said chassis with the top end of the derrick positioned toward the rear of said chassis and the lower end of said derrick being positioned on said chassis toward the front end of said chassis,

(a) space two front and two rear legs for said derrick, cross-bracing between said legs,

(b) said derrick comprising a lower section and an upper section,

G. means for moving said upper section relative to said lower section to collapse and to extend said derrick,

H. a hinge on said derrick positioned adjacent the lower end of said derrick,

(a) said hinge also positioned on said chassis adjacent the front axle and above said driver's position,

I. means for rotating said derrick to an erect position adjacent the front end of said chassis, and

J. means cooperating with the lower ends of said derrick legs to place said legs in load transference relation to the ground with said derrick in erect position;

(a) said lower ends of said legs and said means cooperating therewith

(1) being spaced apart transversely with respect to said chassis a distance greater than the transverse extent of said driver's position; and

(2) said lower ends, said means cooperating therewith, and said hinge being

a. located with respect to the longitudinal axis of said chassis

1. locating said lower ends of one pair of front and rear legs and their respective cooperating means

a. to one side of said driver's position and

b. the lower ends of the other pair of front and rear legs and their respective cooperating means to the other side of said driver's position

c. with the derrick in said erect position.

March 9, 1954 J. MOON 2,671,537

DERRICK MOUNTING FOR PORTABLE DRILLING AND SERVICING RIGS

Filed June 28, 1948 4 Sheets-Sheet 1

Fig. 1.

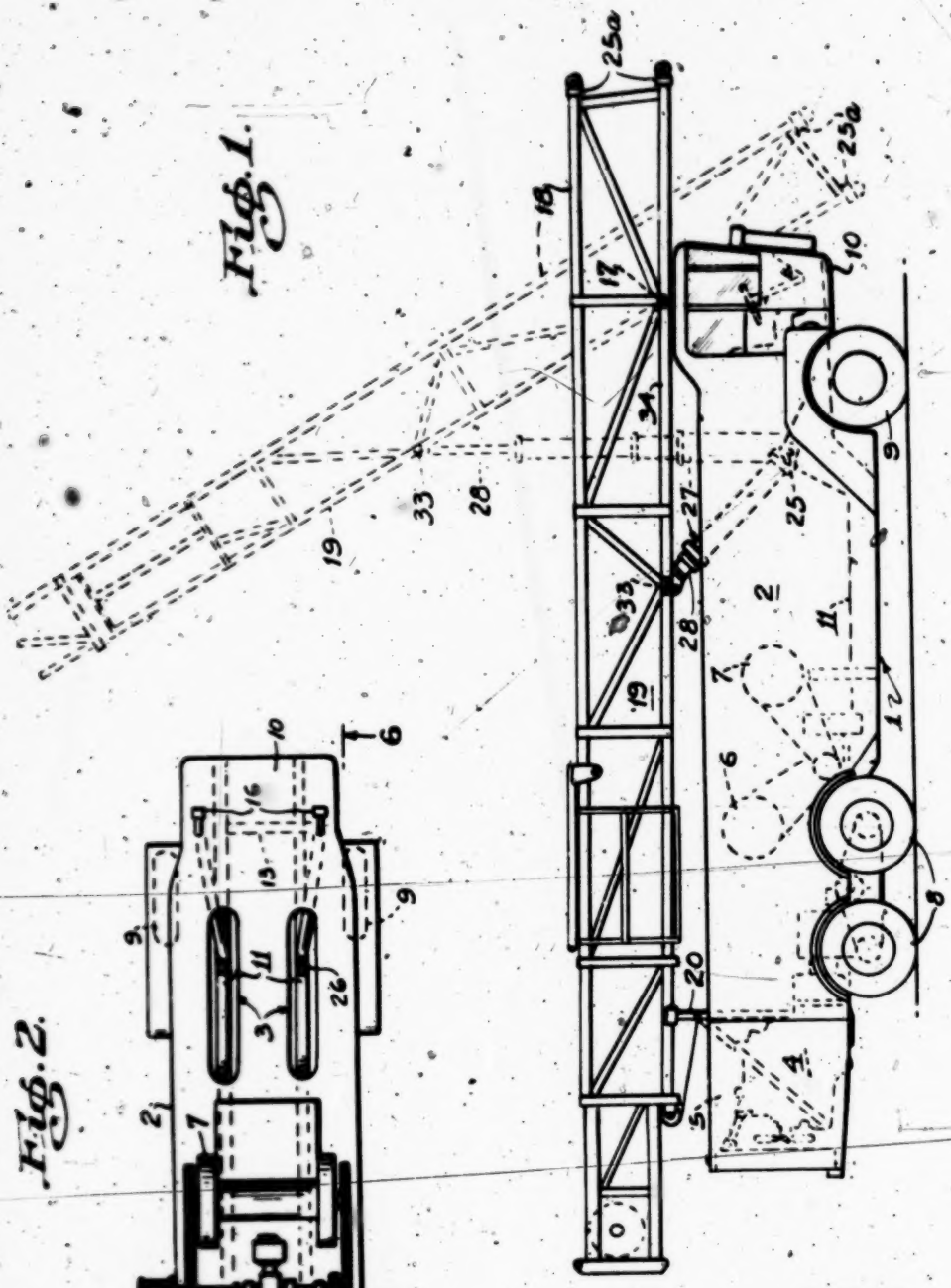
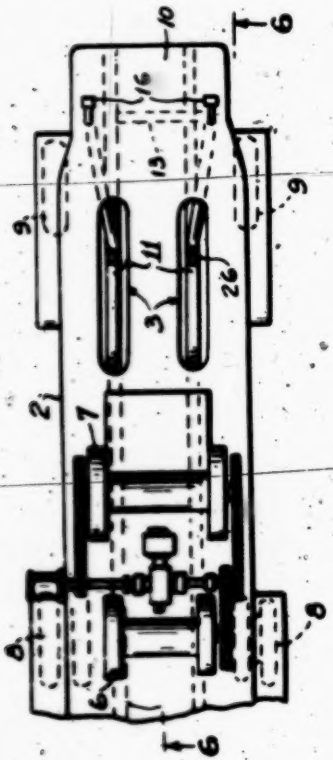


Fig. 2.



INVENTOR.
JAMES MOON
BY Philip Sutton
ATTORNEY.

EXHIBIT "10

March 9, 1954

J. MOON

DERRICK MOUNTING FOR PORTABLE DRILLING AND SERVICING RIGS

2,671,537

Filed June 28, 1948

4 Sheets-Sheet 2

Fig. 4

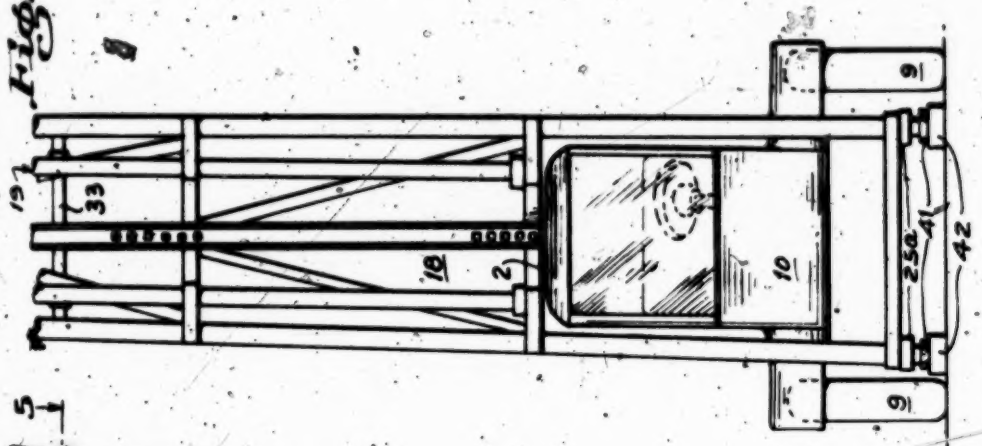


Fig. 3.

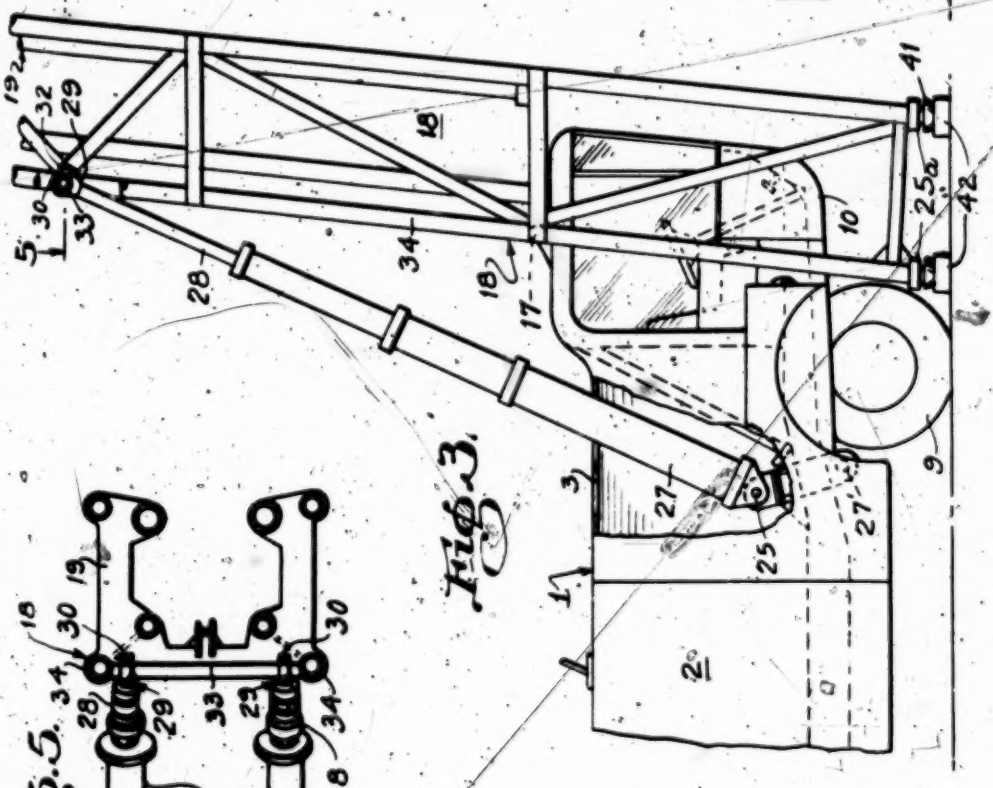
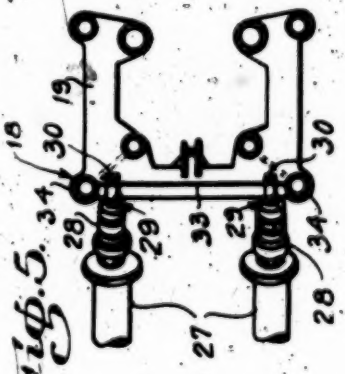


Fig. 5.



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March 9, 1954

J. MOON

DERRICK MOUNTING FOR PORTABLE DRILLING AND SERVICING RIGS

2,671,537

Filed June 28, 1948

4 Sheets-Sheet 3

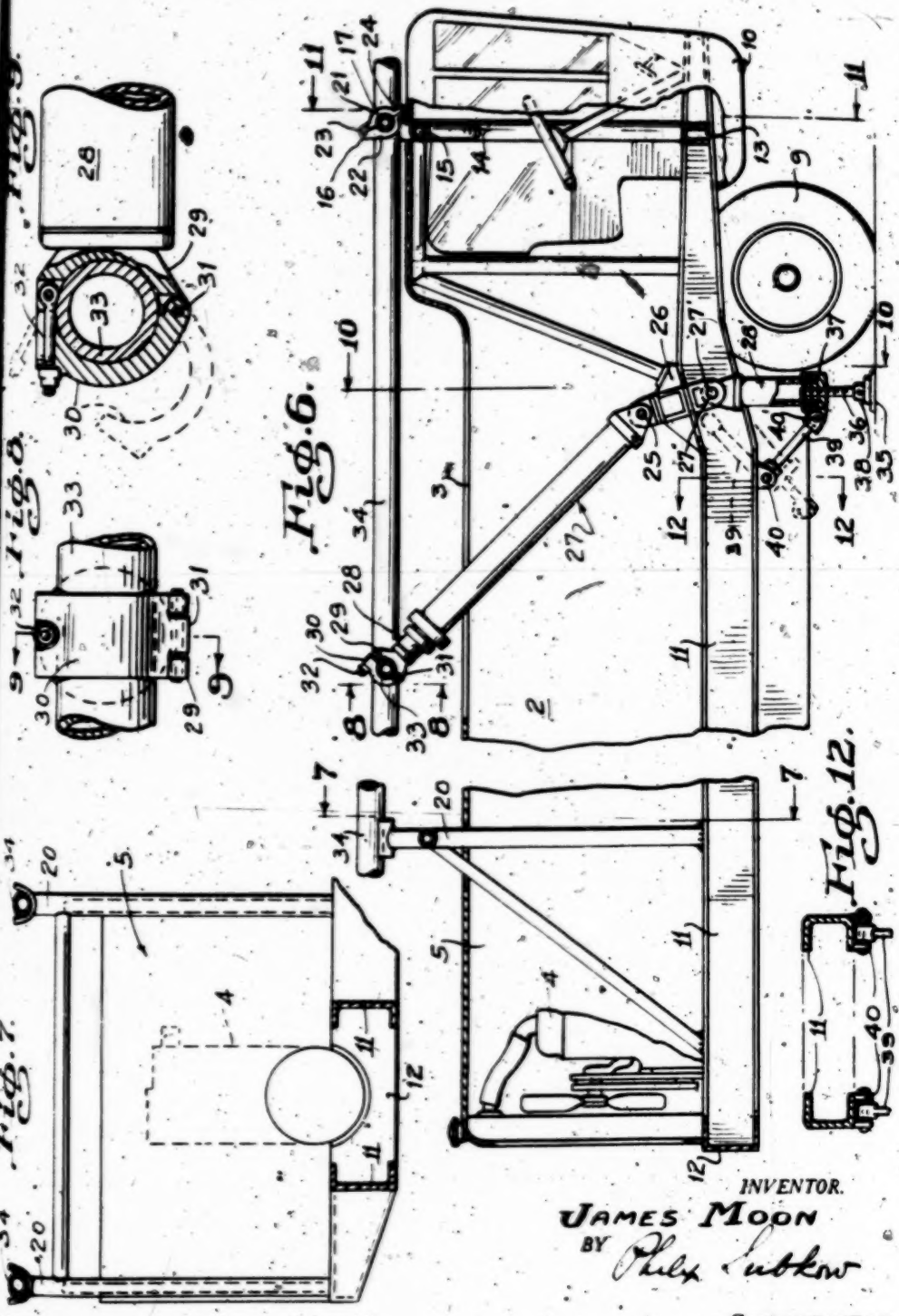


Fig. 3.

Fig. 8.

Fig. 6.

Fig. 7.

Fig. 12.

INVENTOR.

JAMES MOON

BY Philip Lubkow

ATTORNEY.

March 9, 1954 J. MOON 2,671,537

Filed June 28, 1948 DERRICK MOUNTING FOR PORTABLE DRILLING AND SERVICING RIGS 4 Sheets-Sheet 4

Fig. 11.

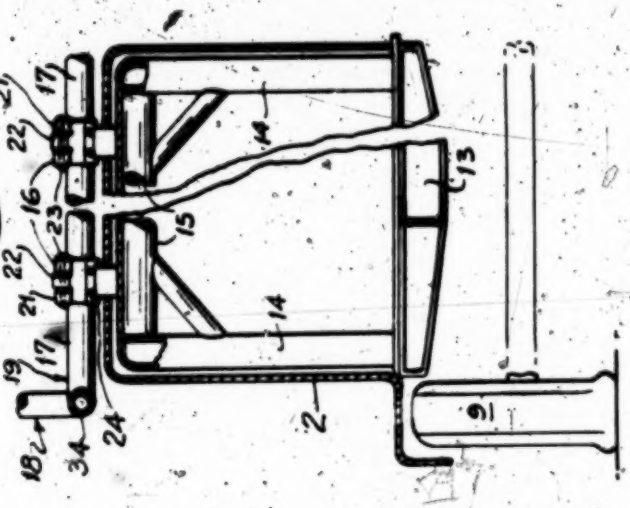
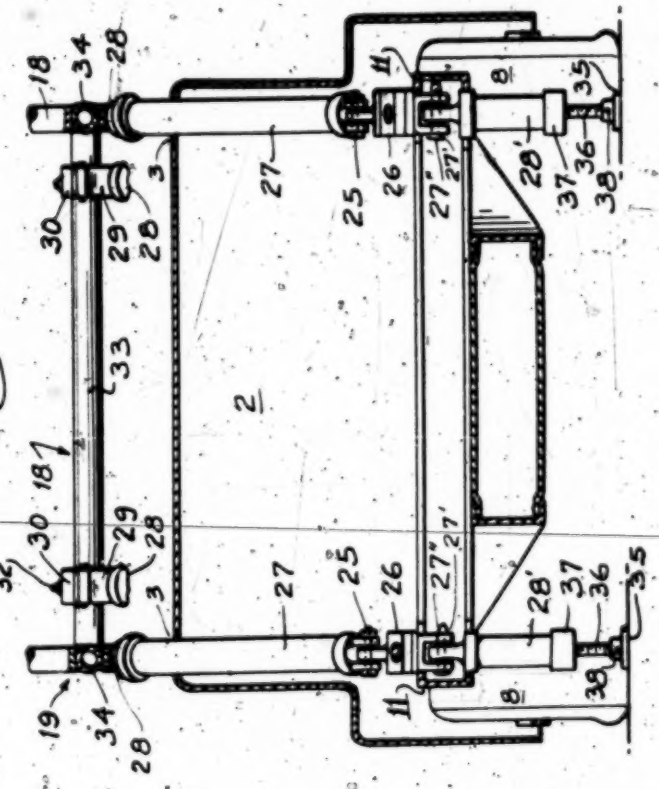


Fig. 10.



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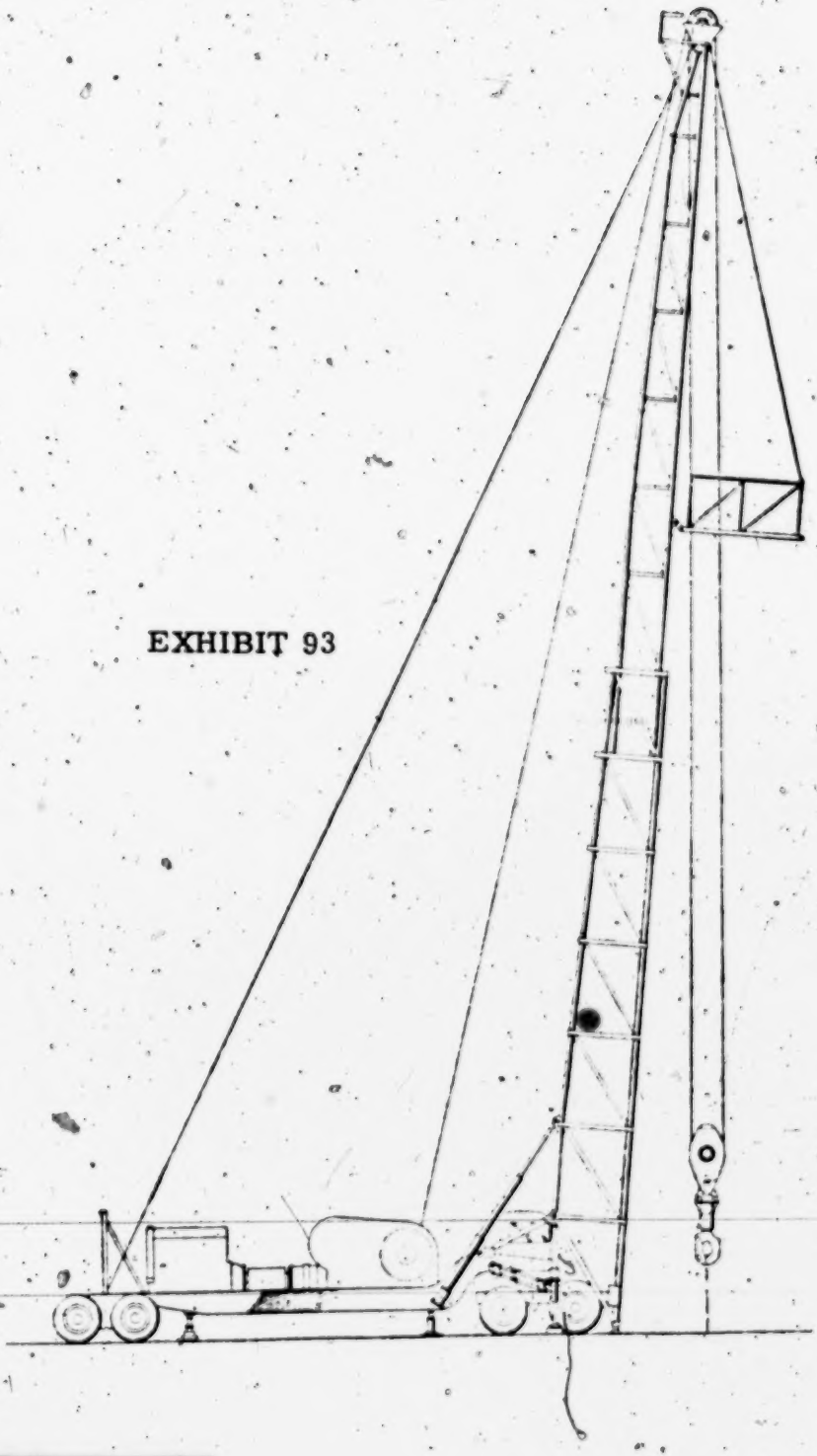
BY Philip Lukens
ATTORNEY

EXHIBIT 93



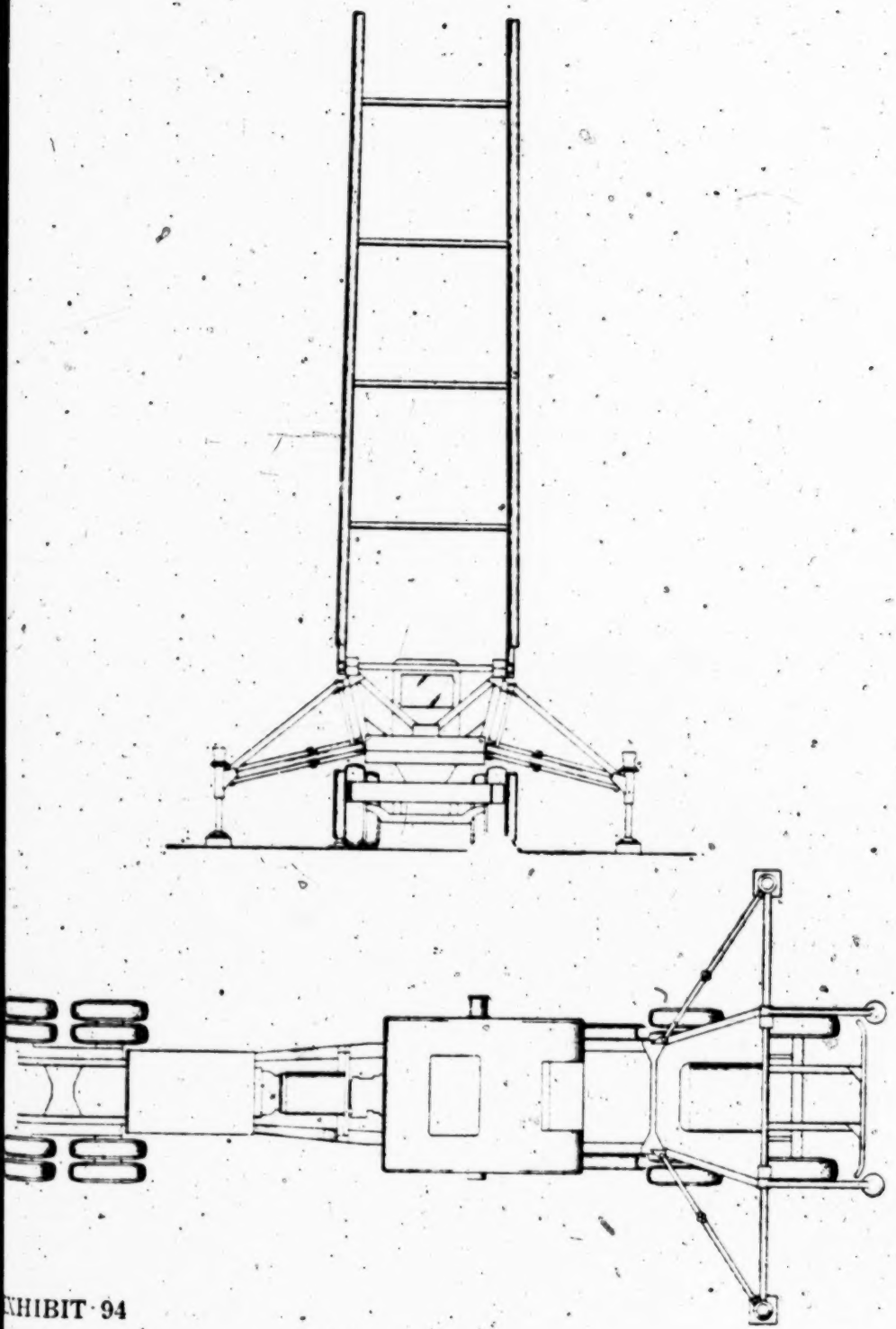


EXHIBIT 94

APPENDIX C.

Smith v. Snow, 294 U. S. 1 at pp. 11, 13-16, 55 S. Ct. 279; 79 L. Ed. 721.

"We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention. *Paper Bag Patent Case*, 210 U. S. 405, 419; *McCarty v. Lehigh Valley R. Co.*, 160 U. S. 110, 116; *Winans v. Denmead*, 15 How. 330, 343. While the claims of a patent may incorporate the specifications or drawings by reference, see *Snow* v. *Lake Shore R. Co.*, 121 U. S. 617, 630, and thus limit the patent to the form described in the specifications, it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice. It is enough that the principle claimed is exemplified by a written description of it and of the manner of using it "in such full, clear, concise, and exact terms as will enable one 'skilled in the art to make, construct, compound and use the same.'" (p. 11) * * *

"It is evident that Claim 1 does not prescribe that the current of air shall be propelled by any particular means, except that it shall be by means other than variation of temperature, nor does it prescribe that the means of propulsion shall be given any particular location, or that the current of air shall be guided by any particular means or given any particular direction. The omission of these requirements from Claim 1 is the more pointed as the other claims of the patent speak in particular of a power-driven fan, of the location of the fan, of curtains and a

partition obviously intended to give direction to the current of air, of a vertically directed current of air, and of air circulating from the bottom of the chamber into the parts of it occupied by the tiers of egg trays. Thus by striking an obviously intended contrast with other claims, Claim 1 covers broadly the essential elements of the Smith invention as we have already described it. *Symington Co.* v. *National Malleable Castings Co.*, 250 U. S. 383, 385; *Lamson Consolidated Store Service Co.* v. *Hillman*, 123 Fed. 416, 419 (C. C. A. 7th); *Wm. B. Scaife & Sons Co.* v. *Falls City Woolen Mills*, 209 Fed. 210, 214 (C. C. A. 6th)."

"Examination of the claim, in the light both of scientific fact and of the particular form in which the petitioner reduced the claim to practice as described in the specifications, makes it plain that the claim does not call for a particular order or arrangement of the eggs in staged incubation in the incubator, or that the propelled current should reach them in any particular order, or that it should be guided, controlled or directed by any particular means, or in any particular manner other than that it should be of sufficient velocity to produce the results prescribed by the claim. If the matter were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made. *Morelcy Machine Co.* v. *Lancaster*, 129 U. S. 263, 273, 277; *Eibel Co.* v. *Paper Co.*, 261 U. S. 45, 63; *Winans* v. *Denmead*, *supra*, 341. In such circumstances, if the claim were fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention, rather than to adopt a construction fatal

to the grant, *Keystone Manufacturing Co.* v. *Adams*, 151 U. S. 139, 144, 145; *McClain* v. *Ortmayer*, 141 U. S. 419, 425.

"2. We find nothing in the file wrapper defense to disturb our conclusion as to the correct interpretation of Claim 1. It is a familiar rule that a patentee cannot broaden his claim by dropping from it an element which he was compelled to add in order to secure his patent. *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 443; *Smith* v. *Magic City Club*, 282 U. S. 784, 789, 790. But the file wrapper lends no support for the application of this rule to petitioner's Claim 1.

"The history of Smith's application in the Patent Office is a long one. Four groups of method claims were successively presented to the Patent Office and three were successively rejected. The fourth group ultimately matured into Claims 1, 2, and 3 of the patent. It suffices to say that Claims 1 and 25 of the first group claimed broadly, 'The method of hatching eggs by arranging the eggs in a column and applying heated air forced about the eggs, the heated air being adapted to the eggs in various stages of incubation,' and 'the method of hatching eggs by arranging the eggs in a column one above the other and forcing heated air through said column.' In due course the broad claims thus asserted were modified and narrowed by the inclusion of new elements, until they appeared in the form of Claim 1 of the patent. But, as we have seen, none of these additions involves any particular order of arrangement of the eggs or any particular direction or control of the air current, except that the current is to be 'of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature.'

"It is an illuminating fact that the entire written argument filed in support of Claim 1, as it was finally presented to the Patent Office and allowed, makes no reference to any order or arrangement of the eggs, or to shifting the location of the eggs in the incubator, no reference to the location of the fan, the direction of the air current, or to curtains or partitions. The features emphasized were the superiority, over drafts caused by variations of temperature, of 'current produced by mechanical means' applied to eggs in staged incubation arranged at different levels, the conservation of moisture, and the elimination of foul air by the restricted air outlets, all features of Claim 1 which are characteristic of both petitioner's and respondents' incubators. We find nothing in the file wrapper to suggest that any addition was made to Claim 1 to restrict the patent to any particular order of arrangement of the eggs or any particular direction or means of control of the current of air, other than its velocity, and nothing to estop the patentee from asserting that the claim is not restricted by such features. See *Baltzley v. Spengler Loomis Mfg. Co.*, 262 Fed. 423, 426 (C. C. A. 2d); *National Hollow B. B. Co. v. Interchangeable B. B. Co.*, 106 Fed. 693, 714 (C. C. A. 8th). It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1. *Westinghouse Electric & Mfg. Co.* v. *Condit Electrical Mfg. Co.*, 194 Fed. 427, 430 (C. C. A. 2d)" (pp. 13-16)

Graver Tank & Mfg. Co., Inc., v. Linde Air Products Co., 339 U. S. 605, 607, 70 S. Ct. 854, 94 L. Ed. 1097, 85 U. S. P. Q. 328.

"In determining whether an accused device or composition infringes a valid patent, resort must be had in

the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.

But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprivate him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.

The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, 15 How. 330, it has been consistently applied by this Court and the lower federal courts and continues today ready and available for utilization when the proper circumstances for its application arise. "To temper unsparing logic and prevent an infringer from stealing the benefit of an in-

vention"[1] a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result," Sanitary Refrigerator Co. v. Winters, 280 U. S. 30, 42 (3 U. S. P. Q. 40, 44). The theory on which it is founded is that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape." Machine Co. v. Murphy, 97 U. S. 120, 125. The doctrine operates not only in favor of the patentee of a pioneer or primary invention, but also for the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results, Imhaeuser v. Buerk, 101 U. S. 647, 655, although the area of equivalence may vary under the circumstances. See Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 414-415, and cases cited; Seymour v. Osborne, 11 Wall. 516, 556; Gould v. Rees, 15 Wall. 187, 192. The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568. In its early development, the doctrine was usually applied in cases involving devices where

[1]Hand in Royal Typewriter Co. v. Remington Rand, 168 F. 2d 691, 692.

there was equivalence in mechanical components. Subsequently, however, the same principles were also applied to compositions, where there was equivalence between chemical ingredients. Today the doctrine is applied to mechanical or chemical equivalents in compositions or devices. See discussions and cases collected in 3 Walker on Patents (Deller's ed. 1937) §§ 489-492; Ellis, Patent Claims (1949) §§ 59-60.

What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case. Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. It does not require complete identity for every purpose and in every respect. In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, things for most purposes different may sometimes be equivalents. Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under

general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience."

Sanitary Refrigerator Co. v. Winters, et al., 280 U. S. 30, 42; 50 S. Ct. 9, 13; 74 L. Ed. 147.

Except where form is of the essence of the invention, it has little weight in the decision of such an issue; and, generally speaking, one device is an infringement of another "if it performs substantially the same function in substantially the same way to obtain the same result. . . . Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape." *Machine Co. v. Murphy*, 97 U. S. 120, 125. And see *Elizabeth v. Pavement Co.*, 97 U. S. 126, 137. That mere colorable departures from the patented device do not avoid infringement, see *McCormick v. Talcott*, 20 How. 402, 405. A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement. *Ives v. Hamilton*, 92 U. S. 426, 430. And even where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee and cannot be extended to em-

brace a new form which is a substantial departure therefrom, it is nevertheless infringed by a device in which there is no substantial departure from the description in the patent, but a mere colorable departure therefrom. Compare *Duff v. Sterling Pump Co.*, 107 U. S. 636, 639."

Angelus Sanitary Can Mach. Co. v. Wilson et al. (9th CCA, 1925), 7 F2d, 314 at p. 318.

"Appellants rely much upon the file wrapper which shows that Wilson's claim 2 (originally claim 6) was rejected and then amended to avoid references (Brenzinger, No. 813,482, Black, No. 858,785, and Wegner, No 1,164,751) cited against them. Originally the claim did not have the words "encircling the can top" before the word 'for,' and prior to Wilson's amendment considerable correspondence was had between the Patent Office and appellants; Wilson contending that the references to Brenzinger and Black were not well founded. Conceding the principle that by amending Wilson is limited to the form and language of the claims as allowed, nevertheless he is not limited to any detailed specific construction to avoid any reference cited against it, nor is he estopped from claiming by the amended claim every improvement and combination which he has invented and which was not disclosed by those references. *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, 106 F. 693, 715, 45 C. C. A. 544; *Owens Co. v. Twin Separator Co.*, 168 F. 259, 93 C. C. A. 561; *Auto Pneumatic Action Co. v. Kindler & Collins*, 247 F. 323, 159 C. C. A. 417.

"To apply that principle: The words 'eccentric encircling ring' are not found in the amendment to Claim 2; nor is the claim limited to exact features, as, for example, was the claim discussed in *Wilson v. Willard Mfg. Co.*,

v. Union Tool Co., 249 F. 729, 161 C. C. A. 639; certiorari denied 248 U. S. 559, 39 S. Ct. 6, 63 L. Ed. 421. Therefore there should be no meaning put upon the words "encircling can top" by which there is a limitation to the eccentric encircling ring, unless the specifications and the drawings, which showed eccentric rings, taken in connection with Wilson's claim 2, make it obvious that he has limited his claim to the use of eccentric rings. The Patent Office may have distinguished Wilson's type of machine from others by reason of specification of the encircling in the first seaming means, but such distinction does not necessarily limit all other elements to that specified eccentric ring with a cam bearing upon it. Interpretation of the claim as allowed may be broad enough to cover improvement other than is disclosed by the references cited against it. In *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., supra*, the court, through Judge Sanborn, said: 'The description in a specification or drawing of details which are not, and are not claimed as, essential elements of a combination, is the mere pointing out of the better method of using the invention. . . . A reference in a claim to a letter or a figure used in a drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that element there shown, unless that particular form was essential to, or embodied the principle of, the improvement claimed.'

"We regard claim 2, in the element of encircling means, as entitled to a construction which includes a fairly liberal range of equivalents. The difference in the use of a mechanical equivalent does not avoid infringement. In *Eibel Process Co. v. Paper Co.*, 261 U. S. 45, 43 S. Ct. 322, 67 L. Ed. 523, the court, through the Chief Justice,

clearly reiterated the doctrine that where an inventor, though not a pioneer in the sense of having created a new art, has made a very useful discovery which has substantially advanced the art, his patent, though but an improvement on an old machine, may be entitled to liberal treatment. That same principle was applied by this court in *Smith Cannery Co. v. Seattle Astoria Iron Works* (C. C. A.) 261 F. 87. Defendants therefore cannot escape infringement by adding to or taking from the patented device by changing its form, or even by making it somewhat more or less efficient, while they retain its principle and mode of operation and attain its results by the use of the same or equivalent mechanical means. *Lourie v. Lenhart*, 130 F. 122, 64 C. C. A. 456; *Letson v. Alaska Packers Association*, 130 F. 129, 64 C. C. A. 463; *Eck v. Kutz* (C. C.) 132 F. 758. By varying the encircling means, but producing the same results in substantially the same manner, there is infringement. Both physical and mechanical encircling with centering are found in defendants' machine. *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. 120, 24 L. Ed. 935; *Kinloch Telephone Co. v. Western Electric Co.*, 113 F. 659, 51 C. C. A. 362; *Auto Pneumatic Action Co. v. Kindler & Collins, supra*; *Paugborn Corporation v. Sly Mfg. Co.* (C. C. A.) 284 F. 217." (p. 318)

Electric Machinery Mfg. Co. v. General Electric Co. (2nd Cir. 1937), 88 F. 2d 11, 16; cert. den., 301 U. S. 702, 81 L. Ed. 1357.

"As to claim 40, infringement depends upon whether the phrase 'running and starting connections' limit it to a combination in which there is a relay for changing from low to high voltage after the motor is started. We adopt what the trial judge said about that: 'The argument is that the word 'motor' as used in the claim means

'primary' or 'armature,' although these words are not employed. The language of the claim is, I think, plainly opposed to any such construction. Moreover, claims 23 and 26, which are not in issue, specify 'starting and running primary connections for said motor,' emphasizing the clear distinction between them and claim 40; and it is a settled rule of construction that the limitations of particular claims cannot be read into other claims, for the purpose of avoiding infringement. Cadillac Motor Car Co. v. Austin, (C. C. A.) 225 F. 983, 985; Automatic Recording Safe Co. v. Burns Co., (C. C. A.) 231 F. 985, 986." So we agree that both claim 8 and claim 40 are infringed" p. 16.

International Cellucotton Products Co. v. Sterilek Co., Inc. (2d C. C. A. 1938), 94 F. 2d 10.

"The validity of the other claims in suit, depends upon what the art had known. There had been a machine in use since 1910 or 1912—Marcus, No. 1,038,493—which made such pads by cutting sections of filler from a continuous web, depositing them upon a gauze web and folding the wrapper around them. The pads themselves were composite, being first built up out of two layers; and the mechanism for wrapping both the outer layer of the pads and the gauze, was in general the same as Bauer's. This was the nearest reference in the immediate field, and to it we shall recur. However, the examiner cited against these claims, as well as against claim 19, the "Johnson & Johnson machine," which we have just mentioned, but about whose structure the filewrapper tells very little. To escape this reference Bauer limited the claims in suit to a machine in which the gauze ran at right angles to the filler web, just as he introduced into claim 19, the other clause just considered. The defendant

bases its case very largely on the assumption that by so doing he conceded that the prior art anticipated the claims except for this interpolated feature. This has been sometimes said in the case of disclaimers, which are in substance limitations imposed after issue; but it is a mistaken view of the law. When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element so introduced. He may merely think that he still retains enough for practical purposes, and that the examiner's insistence does not justify the expense of an appeal. Nor is there any reason to impose upon him the same consequence as though he had formally so conceded; it is enough that he has freed the art except as the claim reads, and that he has surrendered any power under the doctrine of equivalents to resume what he has given up. He has done nothing which need prevent him from insisting in support of the claim as allowed that his invention was broader than the examiner supposed; he is not confined to the examiner's reasoning or committed to his mental processes. United Chromium v. International Silver Co., 2 Cir., 60 F. 2d 913, 915. We cannot therefore recognize the 'Johnson & Johnson machine' for any purpose whatever; it was not proved as a prior use, and until it was, the defendant might not rely upon it." (p. 12)

Kennedy, et al. v. Trimble Nursery-Land Furniture, Inc. (2nd Cir. 1938), 99 F. 2d 786, 788.

". . . The rule is well established that while an invention must describe what the inventor believes to be his best mode in which his inventive idea may be embodied, his patent monopoly is not confined to that. Continental Paper Bag Co. v. Eastern Paper Bag Co., 210

U. S. 405, 418, 28 S. Ct. 748, 52 L. Ed. 1122; Independent Coal Tar Co. v. Cressy Contracting Co., 1 Cir., 260 F. 463, 472. We have said that a court "should never interpret a positively recited generic expression as limited to the precise instrumentality disclosed by the patent, except where such narrow interpretation is necessary to distinguish the claim from the prior art." International Banding Machine Co. v. American Bander Co., 2 Cir., 9 F. 2d 606, 608. Where a patent contains both a broad and a narrow claim and the suit is brought on the broad claim, the court will not read into the broad claim a limitation not therein expressed but which is expressed in the narrower claim; to do so would be changing the contract between the public and the patentee. Electric Machinery Mfg. Co. v. General Elec. Co., 2 Cir., 88 F. 2d 11, 16; O'Rourke Engineering Const. Co. v. McMullen, 2 Cir., 160 F. 933, 939. By thus reading claims 11 and 12 here, the court below reduced them to the same scope as the other claims and we think erred in the application of these rules." (p. 788)

Western States Mach. Co. v. S. S. Hepworth Co. (2d Cir. 1945), 147 F. 2d 345 at pp. 350-351.

"The judge was clearly right in holding claims 3, 6 and 7 invalid, because the "Baltimore Use" had anticipated them. They did not contain the element of stopping the water supply, automatically or otherwise when the rim stops; or the element that the trough should not spill the water left in it. When we are interpreting a series of claims, a limitation not present in one must not be implied, when the same limitation appears in later claims in the series. Symington Co. v. National Malleable Castings Co., 250 U. S. 383, 39 S. Ct. 542, 63 L. Ed. 1045; Cadillac Motor Co. v. Austin, 6 Cir., 225 F. 983, 986;

Electric Machinery Mfg. Co. v. General Electric Co., 2 Cir., 88 F. 2d 11; 16; Chamberlin Metal Weather Strip Co. v. Barringer, 6 Cir., 105 F. 2d 880, 882; Van Heusen Products v. Earl & Wilson, D. C., 300 F. 922; 926." (p. 350)

Musher Foundation v. Alba Trading Co. (2nd Cir. 1945), 150 F. 2d 885 at p. 888, c. d. 326 U. S. 770, 66 S. Ct. 175, 90 L. Ed. 465.

"The defendant insists that the plaintiff is estopped to claim any equivalents by its cancellation of three claims (quoted in the margin[2]), all of which did not contain the element of heat. These claims were not cancelled to escape rejection upon a reference from the prior art cited by the examiner; they were "voluntarily" withdrawn after they had been allowed along with the claims in suit. We are told that the cancellation was for the purpose of inserting them in another pending patent; but, although there is nothing to contradict this, we shall dispose of the case on the assumption that the reason does not appear, for the record is silent. It is of course a well-settled exception to the doctrine of equivalents that, when an examiner rejects a claim upon the prior art and the applicant withdraws it, the disclosure pro tanto passes into

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[2] "1. The method of treating a glyceride oil to give it novel flavor and odor characteristics which comprises forming a salted, dehydrated olive paste, mixing said paste with a glyceride oil, passing said mixture through a colloid mill and removing the undissolved solids."

"2. A glyceride oil composition having novel flavor and odor characteristics containing a small amount of the glyceride oil soluble constituents derived from a dehydrated, salted, low moisture containing, macerated olive paste, the oil being substantially free of the fibers of said olive paste."

"5. The method of treating a glyceride oil to give it novel flavor and odor characteristics which comprise finely macerating a relatively small amount of salted, dehydrated olives with the glyceride oil and then removing the undissolved olive solids therefrom."

the public domain. The applicant may not by resort to the doctrine of equivalent interpret any claim which he succeeds in getting allowed, so that it will cover the contents of the rejected claim without some limitation. Smith v. Snow, 294 U. S. 1, 14, 15, 55 S. Ct. 279, 79 L. Ed. 721; Schreiber Co. v. Cleveland Trust Co., 311 U. S. 211, 220, 61 S. Ct. 235, 85 L. Ed. 132; Exhibit Supply Co. v. Ace Patent Co., 315 U. S. 126, 136, 62 S. Ct. 513, 86 L. Ed. 736. The reason for this is that if the rejection is wrong, the applicant has remedies both in the Patent Office and in the courts: remedies which the cancellation of the rejected claim necessarily surrenders. That surrender does not of course result in a dedication of all species of the genus surrendered; but it does surrender any monopoly upon the genus as such: i.e. unless it be restricted to some species of that genus. When an applicant cancels a claim which has already been allowed, none of this reasoning applies, and at best it becomes an open question which must be proved, whether he intends to surrender the disclosure in such sense that he abandons any equivalents of the elements of those claims which he keeps. Certainly no such intent was proved here. Be that as it may, there is a conclusive reason in this case which would put Claim One outside the exception, even if it had been shown that the applicant had actually intended to surrender the contents of the cancelled claims. All of them contained as an element that the paste or the olives must be salted; and the defendand does not salt the olives out of which it makes its paste. The applicant may well have cancelled the three claims in question precisely, because they did not include that "much less preferable" alternative, which he had disclosed and claimed. We therefore hold Claim One en-

titled to the same range of equivalents as though the three claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a "short" time and a "slightly elevated temperature." B. B. Chemical Co. v. Ellis, 1 Cir., 117 F. 2d 829, 833 was very close on the facts." (p. 888)

Secretary Pen Co. v. Everlast Pen Corp. (2nd Cir. 1951), 189 F. 2d 575, 577.

"It may be noted in further support of the plaintiff's construction of Claim 5, that Claim 7 expressly requires the movable element to be "guided by" the fixed element. This would indicate that Claim 5 is not limited on its face to a sliding contact between the two elements but is broader, as the plaintiffs contend. "When * * * interpreting a series of claims, a limitation not present in one must not be implied, when the same limitation appears in later claims in the series." See opinion of L. Hand, J., in Western States Mach. Co. v. S. S. Hepworth Co., 2 Cir., 147 F. 2d 345, 350. We decide here only the effect of the bare language of the patent and file wrapper history. We do not, and cannot, decide the effect of any additional evidence which may be introduced at the trial." (p. 577)

Kemart Corp. v. Printing Arts Research Laboratories (9th Cir. 1953), 201 F. 2d 624, 633.

"To support his contention that this opinion and judgment is consistent with a finding of infringement of the other claims, appellee invokes the rule that in interpreting a series of claims, a limitation not present in one must not be implied where the same limitation appears in

later claims.[24] The reason of the rule is that each claim is in theory a separate patent, so that two claims should not be so construed as to make them identical.[25]

But this rule of construction is subordinate to the controlling rule that a patentee's broadest claim can be no broader than his actual invention, no matter how it may be expressed or what other claim his patent may contain.[26] (p. 633).

Hunt Tool Company vs. Lawrence (5th C. C. A. 1957), 242 F. 2d 347 at p. 354.

"Also, since the patent examiner's objection was with reference to the prior art, appellants are protected by file wrapper estoppel only if they can show that their alleged infringement is in an area to which the prior art could possibly have been thought to extend so as to make it impossible to make valid claims there, for there is no reason to presume that applicant made a disclaimer broader than necessary to yield to the actual challenge to his claim. See *New York Scaffolding Co. v. Whitney*, 8 Cir., 224 F. 452, 462, certiorari denied, 239 U. S. 640, 36 S. Ct. 161, 60 L. Ed. 482." (p. 354)

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[24]Western States Mach. Co. v. S. S. Hepworth 2 Cir. 147 F. 2d 345, 350, certiorari denied, U. S. 873, 65 S. Ct. 1414, 89 L. Ed. 1991; Grayson Heat Control Ltd. v. Los Angeles Gas Appliance Co. Inc., D. C., 40 Fed. Supp. 928, 935, affirmed 9 Cir., 134 F. 2d 478.

[25]Grayson Heat Control, Ltd. v. Los Angeles Gas Appliance Co., supra, note 24.

[26]Burroughs Adding Mach. Co. v. Felt & Tarrant Mfg. Co., 7 Cir. 243 F. 861, 869, 870, certiorari denied 244 U. S. 659, 37 S. Ct. 745, 61 L. Ed. 1376; Cuno Engineering Corp. v. Meehl, 2 Cir., 113 F. 2d 862, 863; Firestone Tire & Rubber Co. v. United States Rubber Co., 6 Cir., 70 F.2d 948, 960.

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Supreme Court of the United States.

OCTOBER TERM, 1959.

No. 646.

JAMES MOON, EDMOND M. WAGNER AND PHILIP SUBKOW,
Petitioners,

v.

CABOT SHOPS, INC., AND HOWARD SUPPLY COMPANY,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Supreme Court of the United States.

OCTOBER TERM, 1959.

No. 646.

JAMES MOON, EDMOND M. WAGNER AND PHILIP SUBKOW,
Petitioners,
v.
CABOT SHOPS, INC., AND HOWARD SUPPLY COMPANY,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petitioners seek by their petition to upset the decision of the United States District Court for the Southern District of California, unreported, and the affirming decision of the Court of Appeals for the Ninth Circuit, reported at 270 F. 2d 539.

This is a patent case which involved conventional issues of validity and infringement. After a full trial the District Court held the patent valid but not infringed, and the Court of Appeals for the Ninth Circuit affirmed on all points. Although petitioners asked this Court to believe that the decision of the Court of Appeals is in conflict with decisions of this Court and with decisions in other Courts of Appeals, the opposite is true.

The center of petitioners' effort seems to lie in the treatment of claim 5 of the Moon patent in suit, and petitioners allege that the Court imported into that claim a limitation not there expressed but contained only in some or all of the other four claims. They also argue that the Court improperly applied the doctrine of file wrapper estoppel.

These arguments can very quickly be disposed of.

As to Claim 5, the Court Found it Specifically Limited to the "Straddling" Feature.

At pages 12 and 13 of the petition is reproduced the discussion by the Court of Appeals of the five claims in the patent. After pointing out that respondents conceded that claim 1 was limited to the straddling feature, the Court quotes language from claims 2 to 5 and comments:

> "It appears from the quoted portions of the claims that the straddling feature found in claim 1 is present in each of them."

We believe it will be obvious from reading claim 5 that it is very clearly and definitely limited to a construction in which the legs of the derrick "straddle" the cab. What other conclusion could be drawn from the terminal portion of that claim, which reads as follows:

> "and said hinge being located with respect to the longitudinal axis of said chassis locating said lower ends of one pair of front and rear legs and their respective cooperating means to one side of said driver's position and the lower ends of the other pair of front and rear legs and their respective cooperating means at the other side of said driver's position with the derrick in said erect position"!

Since the driver sits in the cab, it is perfectly obvious that the quoted structure means that, when the driver is in his position in the cab, he has two legs of the derrick on one side of him and the other two legs on the other side. If that is not "straddling," it is difficult to see what it could mean.

We submit that the Court of Appeals did not import any limitation into claim 5 which is not clearly expressed in the claim itself.

The Court of Appeals Properly Applied the Doctrine of File Wrapper Estoppel.

The file wrapper of the patent in suit makes it abundantly clear that Moon first sought a broad patent covering the general concept of a derrick pivotally mounted at the front end of a chassis. Throughout several years of prosecution before the Patent Office Moon was entirely unable to convince the Examiner that he had an invention of such breadth. Finally, the Examiner specified that he would only allow claims in which the legs of the derrick straddled the cab (see footnote on page 6 of the petition). Moon thereafter acquiesced, and claims 1 to 4 all include the word "straddle," and claim 5 has language to the same effect. Moon gave up claims directed to the general arrangement of a derrick mounted at the front of the chassis and gave up every version of such an arrangement which did not include the straddling of the cab or driver's position by the legs of the derrick. In respondents' construction all four legs of the derrick are clearly out ahead of the cab. To make claim 5 read on respondents' structure requires a recapture of the precise subject matter which was given up in order to avoid the rejection which the Patent Office consistently applied to every claim which did not include the "straddling" limitation.

Conclusion.

This case does not present any novel or substantial issues of law. Petitioners are dissatisfied with the manner in which the courts below interpreted the patent in suit, its file wrapper, and respondents' structure. We respectfully contend that the facts found by the District Court impelled the result both in that Court and in the Court of Appeals. This case does not have the earmarks of one presenting a situation calling for review by the Supreme Court of the United States.

Respectfully submitted,

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